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October 11, 2005

Mail Stop Appeal Brief - Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Re: Application Serial No.:   09/578,291
      Appellants: Jay Paul Drummond, et al.
      Filing Date: May 25, 2000
      Confirmation No.:   5931
      Title: Automated Banking Machine System With
                               Multiple Entity Interface

      Docket No.:   D-1077+15

Sir:

Please find enclosed the Brief of Appellants pursuant to 37 C.F.R. § 41.37 for filing in the above-referenced application.

Please charge the fee required with this filing ($500) and any other fee due to Deposit Account 09-0428 of InterBold.

Very truly yours,

Ralph E. Jocke
Reg. No. 31,029

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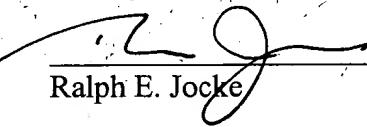
Ralph E. Jocke

D-1077+15

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of:	)	
Jay Paul Drummond, et al.	)	
	)	Art Unit 3624
Serial No.: **09/578,291**	)	
	)	
Confirm. No.: **5931**	)	
	)	
Filed: **May 25, 2000**	)	Patent Examiner
	)	**Kelly Scaggs Campen**
For: **Automated Banking Machine**	)	
System With Multiple Entity	)	
Interface	)	

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P.O. Box 1450
Alexandria, VA 22313-1450

BRIEF OF APPELLANTS PURSUANT TO 37 C.F.R. § 41.37

Sir:

The Appellants hereby submit their Supplemental Appeal Brief pursuant to 37 C.F.R. §

41.37 concerning the above-referenced Application.

(i)   **REAL PARTY IN INTEREST**

The Assignee of all right, title and interest to the above-referenced Application is Diebold, Incorporated, an Ohio corporation.

(ii)   RELATED APPEALS AND INTERFERENCES

This application is a continuation-in-part application of U.S. Application Serial No. 09/193,787 filed November 17, 1998 which is currently on appeal before the Board of Patent Appeals and Interferences. In addition, U.S. Application Serial No. 09/193,787 is a continuation-in-part application of PCT/ US97/21422 filed November 25, 1997 (now U.S. Application Serial No. 09/077,337) which is also currently on appeal before the Board of Patent Appeals and Interferences. A copy of the decision dated October 8, 2003 and rendered by the Board for U.S. Application Serial No. 09/193,787 (Appeal No. 2003-1651) is attached in the RELATED PROCEEDINGS APPENDIX.

In addition, U.S. Application Serial No. 09/193,791 filed on November 17, 1998 shares the identical Specification as U.S. Application Serial No. 09/193,787 and likewise is a continuation-in-part application of PCT/ US97/21422. The Board of Patent Appeals and Interferences rendered a decision related to this application dated March 9, 2005. A copy of this decision (Appeal No. 2004-1824) is also attached in the RELATED PROCEEDINGS APPENDIX.

The decision of the Board in U.S. Application Serial No. 09/193,791 (Appeal No. 2004-1824) construed the following references which form the basis for rejection of claims pending in the present application:

Los Angeles Times article, "TRADE IT YOURSELF BANK MACHINES MAKE A DEBUT"; and

Infoworld article, "TP-Monitor Vendors Spin Web features".

Although U.S. Application Serial No. 09/193,791 claims different subject mater than the present application, the Board's interpretation of the teachings of these cited references in Appeal No. 2004-1824 supports Appellants' arguments below that pending claims 1-32 are neither anticipated nor obvious in view of these references.

Appellants, Appellants' legal representative, and the assignee of the present application are not aware of any other prior and pending appeals, interferences or judicial proceedings which may be related to, directly affect or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1-32 are pending in the Application.

Claims rejected:	1-32
Claims allowed:	none
Claims confirmed:	none
Claims withdrawn:	none
Claims objected to:	none
Claims canceled:	none

Appellants appeal the rejections of claims 1-32. These claim rejections were the only claim rejections present in the Office Action ("Action") dated July 15, 2005, which was made non-final and which had reopened prosecution in view of Appellants' first Appeal Brief filed February 3, 2005. Claims 1-32 have been rejected at least twice.

(iv)   **STATUS OF AMENDMENTS**

A non-final rejection was made July 15, 2005. No amendments to the claims were requested to be admitted after the non-final rejection.

Additional Comment

In a paper filed August 4, 2005, Appellants submitted a request to correct the "Parent Continuity Data" listed in the Office's PAIR system. Appellants also submitted an Application Data Sheet to aid the Office in correcting the Parent Continuity Data listed for the application.

In response, the Office has updated the Parent Continuity Data to be consistent with Appellants' corrected Filing Receipt dated November 16, 2000 and Appellant's original "New Application Transmittal" ("Transmittal") paper filed May 25, 2000.

Appellants' Transmittal which was filed in accordance with the rules at the time of filing the application, included a valid claim for benefit of earlier filed applications under 35 U.S.C. § 120 and 35 U.S.C. § 119(e). Appellants' Transmittal which was filed in accordance with the rules at the time of filing the application also included a request (at pages 4 and 5) to insert before the first line of the Specification, a reference to the prior applications and their filing dates for which benefit is claimed.

Thus the present application **at the time of filing** fully complied with the requirements in effect at that time for receiving the benefit of earlier filing dates of prior applications under 35 U.S.C. § 120 and 35 U.S.C. § 119(e). Thus the present application is a continuation-in-part of Application Serial No. 09/193,787 filed November 17, 1998 and claims the benefit of Provisional Application Serial No. 60/149,765 filed August 19, 1999. Further, Application

Serial No. 09/193,787 is a continuation-in-part of Application Serial No. 09/077,337 filed as

PCT/US97/21422 on November 25, 1997 and claims the benefit of Provisional Application

Serial Nos. 60/031,956 filed November 27, 1996; 60/091,887 filed July 7, 1998; 60/095,626 filed

August 7, 1998; and 60/098,907 filed September 2, 1998.

(v)   SUMMARY OF CLAIMED SUBJECT MATTER

Concise explanations of exemplary forms of the claimed invention:

With respect to independent claim 1

An exemplary form of the invention is directed to a method. The method comprises the

step of determining through operation of an automated banking machine, data corresponding to

an entity with which a customer operating the machine has an account. Examples for this

method step described in the Specification include the user having indicia corresponding to a

system address on a card that is read by a card reader in the banking machine or by another input

device, which indicia identifies the user or an institution or entity with which the user has an

account (Page 9, lines 5-8). Figure 2 shows an example of an automated banking machine such

as an ATM (12) which includes a reader such as a card reader/writer mechanism (38).

As described at Page 25, lines 5-15 of the Specification, the address stored on the card

may correspond to a uniform resource locator ("URL") address. This data corresponding to an

address may be recorded on track 3 of a magnetic stripe or in other locations in the magnetic

stripe data or through encoding other readable indicia on the card. Alternatively, if the

customer's card is a "smart" card which includes semiconductor storage thereon, the URL

address associated with the customer may be included as part of the stored data on the integrated circuit chip on the customer's card.

In another embodiment (Page 25, line 16 to page 26, line 4; page 48, lines 1-15), the URL could be derived from other data on the card by accessing a database in which card data is correlated with address data. For example, a "bank identification number" (BIN) may be read from a card. The automated banking machine may operate to resolve a network address from the card data by accessing a database which includes BIN data or other entity data correlated with network address data.

In addition to the above described determining step, this exemplary form of the invention comprises the step of providing through an output device on the automated banking machine, at least one output uniquely corresponding to the entity with which the customer has the account. As discussed in the Specification at page 26, lines 1-7, the automated banking machine may use the network address obtained from the card or resolved from card data, to access a server operated by the entity with which the user has an account relationship. HTML documents or other types of documents accessed at the address may provide interface screens and transaction flows from the customer's familiar home institution or entity, even though the machine the customer is operating is not controlled by that entity.

Figure 3 shows an example of an HTTP home server (90) and a foreign server (96) which operate to deliver at least one HTML document to a browser (76) of the automated banking machine (12). Figures 19 through 22 graphically represent the operation of an exemplary system when a "foreign" user uses the ATM (12) (Page 48, line 1, page 54, line 21). Examples of output devices through which outputs from the browser are directed include a display device such as a

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touch screen (30) (Figure 2). However, the automated banking machine may include other types of output devices such as audio speakers (Page 13, lines 16-22).

With respect to independent claim 8

Another exemplary form of the invention is directed to a method which comprises the step of reading card indicia on a card presented by a customer to an automated banking machine (12) (Figure 2). The card indicia includes entity data corresponding to an entity with which the customer has an account (Page 9, lines 5-8; page 25, line 5 to page 26, line 4). An example of entity data read from a card may include a "bank identification number" (BIN).

This described exemplary form of the invention also comprises the step of resolving network address data with the banking machine responsive to the entity data and data stored in a data store (Page 48, lines 1-15). In addition, this described exemplary form of the invention comprises operating a browser (76) in the banking machine responsive to the resolved network address data, to access at least one network address in a network. The network address accessed corresponds to an address of a server (90, 96) adapted to deliver documents corresponding to the entity with which the customer has the account. Figure 3 shows an example of an HTTP home server (90) and a foreign server (96) which operate to deliver at least one HTML document to a browser (76) of the automated banking machine (12). Figures 19 through 22 graphically represent the operation of an exemplary system when a "foreign" user uses the ATM (12) (Page 48, line 1, page 54, line 21).

As discussed in the Specification at page 26, lines 1-7, the automated banking machine may use the network address obtained from the card or resolved from card data to access a server

operated by the entity with which the user has an account relationship. HTML documents or other types of documents accessed at the address may provide interface screens and transaction flows from the customer's familiar home institution or entity, even though the machine the customer is are operating is not controlled by that entity.

With respect to independent claim 19

Another exemplary form of the invention is directed to an apparatus comprising a plurality of institution servers (20-28) (Figure 1). Each institution server is associated with one of a plurality of financial institutions (Page 13, lines 8-15). Each institution server has at least one unique network address, and each institution server is operative to deliver at least one document associated with the respective institution (Page 9, lines 12-18; page 26, lines 1-7). The apparatus also comprises a network (14) in operative connection with each of the plurality of institution servers. In addition, in this described exemplary form of the invention, the apparatus comprises at least one automated banking machine (12) such as an ATM. As shown in Figure 2, the automated banking machine includes a computer (34) having a browser (76) operating therein, a card reader (38) and an output device (30) in operative connection with the computer (Page 13, line 16 to page 14, line 3). The automated banking machine is operative responsive to reading card indicia on a card read by the card reading device, to cause the browser to connect through the network to a network address of an institution server corresponding to the card indicia (Page 8, line 21 to page 9, line 18). Figures 19 through 22 graphically represent the operation of an exemplary system when a "foreign" user uses the ATM (12) (Page 48, line 1, page 54, line 21).

(vi)   GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds to be reviewed in this appeal are:

Whether Appellants' claims 1-32 are anticipated under 35 U.S.C. § 102(b) by the Los Angeles Times article, "TRADE IT YOURSELF BANK MACHINES MAKE A DEBUT" ("LA Times").

Whether Appellants' claims 1-32 are unpatentable under 35 U.S.C. § 103(a) over LA Times.

Whether Appellants' claims 1-32 are unpatentable under 35 U.S.C. § 103(a) over LA Times in view of Infoworld article, "TP-Monitor Vendors Spin Web features" ("Infoworld") or Anderson, et al., U.S. Patent No. 5,706,442 ("Anderson").

(vii)   ARGUMENT

LA Times

The LA Times article is directed to Citibank using ATMs to offer brokerage services. Citibank uses a "specially designed" ATM that keeps the brokerage services "separate" from the banking services via different menus.

In addition, the Board stated the following in its decision dated March 9, 2005 in the Appeal No. 2004-1824 for Application No. 09/193,791: "LA Times discloses that Citibank offers an automatic teller machine (ATM) that lets users buy and sell stocks, get market values

for securities, and trade shares of the bank's money market funds. The ATMs have separate menus for banking and brokerage services, and a screen offers a choice between information and trading. If trading is chosen, the next screen is a full page of disclosure about stock market risks. Those who just want to check stock prices will pull up a picture of a typewriter keyboard. By touching the screen, they can type in the name of the company or its ticker symbol and get a real-time stock quote or the previous day's mutual fund closing price."' (Board decision at page 3).

Infoworld

The Infoworld article is directed to a TP monitor called "Top End." It is well known that a "TP" monitor is an abbreviation for a "transaction processing" monitor. A plethora of information on TP monitors is available, including information which may be found via the Internet. A TP monitor is a program that monitors or tracks a transaction as it passes from one stage in a process to another, including across different computer systems. The TP monitor can provide transaction and data integrity by ensuring that each tracked transaction gets processed to completion or is otherwise completely rolled back. Thus, for example, a TP monitor can make sure that groups of updates that are supposed to take place together actually do all take place, or otherwise none take place. A TP monitor may also be useful in balancing system loads and in recovery from system failures. For example, a TP monitor may be used to monitor whether a message sent from a sending application program was successfully transmitted and received by a receiving application. In the event of a failure as determined by the TP monitor, the failed message can be either resent or switched over to a process on another node.

Infoworld teaches that Top End is "middleware" software that lets users deploy point-of-sale applications. Top End is apparently applicable to tracking transactions conducted using credit cards at ATMs and cash registers to be sure they are properly processed. A Web-specific version of Top End newly written at the time of the article has client code written as a set of Java class libraries. The Java client running in the cash register or ATM downloads the transaction data by establishing a direct link to the Top End remote back-end system. The back-end system records and stores the data about the transactions. In this way, the client directly connects to the Top End back office (away from the ATM or cash register) through a (TCP/IP) connection. The Top End client can send transaction data from the cash register or ATM to the remote back-end system (which charges the customer's account for the transaction) to reduce the risk that the transaction is not properly processed.

In addition, the Board stated the following in its decision dated March 9, 2005 in the Appeal No. 2004-1824 for Application No. 09/193,791: "Infoworld discloses that NCR Corp. 'is out to turn the Internet into a giant virtual cash register with enhancements to its Top End middleware that will let users deploy point-of-sale applications over the World Wide Web.' NCR 'delivered a Java client to the Top End transaction processing (TP) monitor, a Web specific version of Top End designed to take advantage of the Internet and bypass weaknesses in standard Internet protocols', and 'has rewritten the Top End client code, which runs on PCs and sits inside automated teller machines and cash registers, as a set of Java class libraries.' 'Rather than establishing a client-to-server connection using Common Gateway Interface (CGI) the Java client downloads into the Web browser and establishes a direct link to the Top End back-end

application.' Thus, '[i]nstead of going through the Web server and CGI on the back end, [NCR] let Java set up a private TCP/IP connection.'" (Board decision at pages 3-4).

Anderson, U.S. Patent No. 5,706,442

Anderson is directed to a system for delivering financial information. Anderson's proprietary "Conductor system" is a sophisticated computer software system based on distributed system technology (Col. 1, lines 56-57). The distributed system includes a "Conductor system" architecture network. The system works to provide financial information to users. The system permits users to review activity and balances relating to their accounts. For example, the system permits a user to use a PC to "access information regarding recent account activity or their account balances" (Col. 1, lines 12-14) "so that users may review activity and balances" (Col. 2, line 1). Anderson's financial information service system is capable of servicing (fulfilling) financial information requests (Col. 5, lines 24-47; col. 6, lines 19-23). The information requests are related to the viewing of account information, such as recent debit card transactions (Col. 5, lines 28-31). The requested financial information may be transmitted back to the user (Col. 5, lines 44-47; col. 1, lines 52-55). Anderson's service enables a user to check or verify the customer's bill payments.

The 35 U.S.C. § 102 (b) Rejections

<u>The Applicable Legal Standards</u>

Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Anticipation under 35 U.S.C. § 102 requires in a single prior art disclosure, each and every element of the claimed invention arranged in a manner such that the reference would literally infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 USPQ2d 1766, 1768 (Fed. Cir. 1987).

Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency the Office must prove through citation to prior art that the feature alleged to be inherent is "necessarily present" in a cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999).

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

Rejection under 35 U.S.C. § 102(b) over LA Times

Claims 1-32 were rejected under 35 U.S.C. § 102(b) as being anticipated by LA Times. These rejections are respectfully traversed.

Claim 1

Claim 1 is an independent claim directed to a method. The Action (Page 6) alleges that an ATM in LA Times "is considered to perform all the banking functions of a typical ATM, such as account access, transfer funds, dispense cash, dispense receipts, dispense statements, etc. The Citibank ATM is also considered to possess all the normal components and component interrelationships of an ATM machine such as a card reader, currency output device and a currency sheet dispenser, a receipt output device including a receipt sheet dispenser, etc., and a computer in operative connection with the output devices and the currency sheet dispensers." The Appellants respectfully take issue with this assertion because the article contains no such teachings.

The asserted banking functions that the Action says the LA Times ATM is "considered to perform" and the components that the ATM is "considered to possess" are not disclosed by the reference. The assertions are based on improper speculation by the Office. LA Times contains no teachings regarding banking functions and components included with the ATM. For example, where does LA Times specifically teach that the ATM is able to provide account access, transfer funds, and dispense statements, especially in 1994?

Appellants respectfully disagree that the ATM components that the Action alleges the reference teaches, are inherent in LA Times. Anticipation by inherency requires that the Office

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establish that persons skilled in the art would recognize that the missing components are necessarily present in the LA Times reference. To establish inherency the Office must prove through citation to prior art that the features alleged to be inherent are "necessarily present" in LA Times. However, there is no teaching in LA Times that the ATM is able to provide account access, transfer funds, and dispense statements. Nor has the Office proved that every ATM is able to provide account access, transfer funds, and dispense statements. That is, the Office has not proved through citation to prior art that the alleged features are "necessarily present" in LA Times. Inherency may not be established based on probabilities or possibilities (which is the present situation). It is plainly improper to reject a claim based merely on the (speculative) possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999).

Nor has the Action established through citation to prior art what constitutes the alleged "normal components" or "a typical ATM" at the time of the present application. Nor is there any teaching or suggestion that an ATM in LA Times is "a typical ATM", as alleged. Contrarily, LA Times specifically teaches that the ATM is "specially designed" (i.e., atypical). The limited locations (and thus quantity) of the ATMs also points to their uniqueness. Thus, in light of Appellants' contrary showing, the assertion in the Action that LA Times has "a typical ATM" with "normal components" is not legally appropriate.

The Action's assertions are not based on any evidence in the record. An assertion of prior art knowledge not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, supra. The determination of patentability must be based on evidence of record. *In re Lee*,

supra. Appellants respectfully submit that because the rejection is based on mere assertions and not proper evidence of record, it is not a legally valid rejection.

Further, the Action has failed to show where each of the method steps recited in claim 1 are shown in LA Times. For example, where does LA Times teach "determining through operation of an automated banking machine, data corresponding to an entity with which a customer operating the machine has an account"?

LA Times says nothing about the machine determining data corresponding to an entity. There is no teaching in LA Times that the machine operates to determine such data corresponding to an entity with which the user of the machine has an account. Indeed if these special LA Times machines only work for Citibank customers, why would the machine have any need to determine data that corresponds to an entity with which the customer has an account? There is no teaching of these recited features and relationships in the LA Times article.

In addition, LA Times does not teach "providing through an output device on the automated banking machine at least one output uniquely corresponding to the entity with which the customer has the account." Nowhere does LA Times disclose providing such an output corresponding to such an entity, based on machine determined data. LA Times states that its "specially designed automated teller machines have separate menus for banking and brokerage services". However, nowhere does LA Times teach providing an output which uniquely corresponds to an entity with which the customer has an account. LA Times does not teach providing an output from the machine uniquely corresponding to any entity, let alone an entity that corresponds to data determined by the machine as the entity with which the customer has an

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account, as specifically recited. As LA Times does not teach all of the features and relationships recited in the claim, the anticipation rejection is not legally proper.

Further, the Office has not shown through citation to any evidence, that all of the recited steps, features and relationships are "necessarily present" in LA Times. Nor has the Office provided evidence to support the assertion in the Action, that *every* ATM known to those skilled in the art as of the effective filing date of the application, performs the recited steps.

LA Times does not explicitly or inherently teach all the recited features, relationships, and steps. For all of these many reasons, LA Times does not anticipate claim 1. Therefore, Appellants respectfully submit that the 35 U.S.C. § 102(b) rejection should be reversed.

Claim 2

Claim 2 depends from claim 1 and further recites that step (a), which includes determining data, also includes reading indicia with a reading device in operative connection with an automated banking machine. LA Times makes no mention of any type of reading device. LA Times does not explicitly or inherently teach this feature, and therefore does not anticipate claim 2.

Claim 3

Claim 3 depends from claim 2 and further recites that step (a) includes reading indicia on a card with a card reader in connection with an automated banking machine. LA Times makes no mention of a card reader. LA Times does not explicitly or inherently teach this feature and therefore does not anticipate claim 3.

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Claim 4

Claim 4 depends from claim 1 and further recites that step (b) further includes providing at least one visual output corresponding to the entity with which the customer has the account, through the output device. LA Times discloses no outputs associated with such an entity as determined by the machine, let alone a visual output. LA Times does not explicitly or inherently teach this feature and therefore does not anticipate claim 4.

Claim 5

Claim 5 depends from claim 4 and further recites that step (b), which includes providing a visual output, includes processing at least one document through a browser operating in a computer in operative connection with an automated banking machine. The Action admits (at page 8, lines 3-4) that LA Times does not disclose this feature. As the LA Times does not explicitly or inherently teach this feature, LA Times does not anticipate claim 5.

Claim 6

Claim 6 depends from claim 5 and further recites that in step (b) the document (processed through a browser to produce an output) is determined responsive to data corresponding to an entity with which the customer has the account, which data is determined through operation of an automated banking machine. LA Times does not explicitly or inherently teach this feature and therefore does not anticipate claim 6.

Claim 7

Claim 7 depends from claim 6 and further recites that step (b) includes accessing the at least one document at a system address. Claim 7 further recites that the system address is determined responsive to data corresponding to an entity with which the customer has the account, which data is determined through operation of an automated banking machine. LA Times does not explicitly or inherently teach this feature and therefore does not anticipate claim 7.

Claim 8

Claim 8 is an independent claim directed to a method. As discussed previously with respect to claim 1, the banking functions the Action asserts that the ATM of LA Times is "considered to perform" and the components that the ATM is "considered to possess" are actually not taught by the reference. Rather, these assertions constitute nothing more than unsupported speculation. LA Times is silent as to the available banking functions and components included with the "specially designed" ATMs. For example, where does LA Times specifically teach that the ATM is able to provide account access, transfer funds, and dispense statements, especially in 1994?

Appellants respectfully disagree that the alleged ATM components such as a card reader are inherent in LA Times. Anticipation by inherency requires that the Office establish that persons skilled in the art would recognize that the missing components are "necessarily present" in the LA Times reference. To establish inherency the Office must prove through citation to prior art that the features alleged to be inherent are "necessarily present" in LA Times.

There is no teaching in LA Times that the described "specially designed automated teller machines" include a card reader, or are able to provide account access, transfer funds, and dispense statements as asserted in the Action. Nor has the Office proved through citation to prior art the assertion in the Action that every ATM at the time of the effective filing date included a card reader, and was able to provide account access, transfer funds, and dispense statements. That is, the Office has not proved through citation to prior art that the alleged features are "necessarily present" in the ATM of LA Times. Nothing prevents these "specially designed" Citibank ATMs from operating without a card reader, such as by input of brokerage account numbers by a user, for example. Inherency may not be established based on probabilities or possibilities (which is the present situation). It is plainly improper to reject a claim based merely on the (speculative) possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999).

Nor has the Action established in the prior art what constitutes the alleged "normal components" or "a typical ATM." Nor is there any teaching that an ATM in LA Times is "a typical ATM", as alleged. Contrarily, LA Times specifically teaches that the ATM is "specially designed" (i.e., atypical). The limited locations (and thus quantity) of the ATMs also points to their uniqueness. Thus, in light of Appellants' contrary showing, the assertion that LA Times has "a typical ATM" with "normal components" is not legally supportable and runs directly counter to the express teachings of the reference.

The Action's assertions are not based on any evidence in the record. An assertion of prior art knowledge not based on any evidence in the record lacks substantial evidence support. *In re*

Zurko, supra. The determination of patentability is required to be based on evidence of record. *In re Lee*, supra. Appellants respectfully submit that because the rejection is based on mere speculative assertions and not proper evidence of record, it is not a valid rejection.

Further, the Action has failed to show where each of the method steps recited in claim 8 are taught in LA Times so as to support the anticipation rejection. For example, where does LA Times disclose or suggest "reading card indicia on a card presented by a customer to an automated banking machine, the card indicia including entity data corresponding to an entity with which the customer has an account"? It doesn't.

In addition, where does LA Times disclose or suggest "resolving network address data with the banking machine responsive to the entity data and data stored in a data store"? LA Times says nothing about a machine resolving network address data. LA Times further says nothing about resolving data responsive to entity data on a card or in a data store.

Further, where does LA Times disclose or suggest "operating a browser in the banking machine responsive to the resolved network address data, to access at least one network address in a network"? LA Times makes no mention of a browser or accessing resolved network address data. Where does LA Times disclose or suggest that "the network address accessed corresponds to an address of a server adapted to deliver documents corresponding to the entity with which the customer has the account"? Nowhere does LA Times disclose delivering documents, such as HTML documents, or any of these steps recited in claim 8, as would be necessary to sustain the anticipation rejection.

As discussed with respect to claim 5, the Action admits (at page 8, lines 3-4) that LA Times does not disclose operating a browser in an automated banking machine. Therefore, by

the Action's own admission, LA Times can not explicitly or inherently teach each of the recited features, relationships, and steps recited in claim 8. For all of these many reasons, LA Times does not anticipate claim 8. Therefore, Appellants respectfully submit that the 35 U.S.C. § 102(b) rejection should be reversed.

Claim 9

Claim 9 depends from claim 8. Claim 8 further recites processing at least one document from the server corresponding to the entity with which the customer has the account, and providing at least one output through an output device of an automated banking machine responsive to the at least one document. LA Times does not explicitly or inherently teach each of these features and therefore does not anticipate claim 9.

Claim 10

Claim 10 depends from claim 9. Claim 9 further recites providing at least one visual output through a display of an automated banking machine responsive to a document corresponding to an entity with which the customer has an account. LA Times does not explicitly or inherently teach this feature and therefore does not anticipate claim 10.

Claim 11

Claim 11 depends from claim 8. Claim 8 further recites processing the first document with a browser in the automated banking machine. In addition, Claim 11 further recites operating a transaction function device of the banking machine responsive to the at least one

instruction in the first document. It is admitted in the Action that LA Times does not teach a browser. Certainly it does not teach a browser that processes document instructions that cause operation of a transaction function device of the machine. LA Times does not explicitly or inherently teach these features and therefore does not anticipate claim 11.

Claim 12

Claim 12 depends from claim 8. Claim 12 further recites providing a plurality of servers, one for each of a plurality of entities with which a plurality of users of the automated banking machine have accounts. Claim 12 further recites that each server is in operative connection with a network, has a corresponding network address, and is adapted to deliver at least one document corresponding to the entity with which it is associated. Claim 12 further recites repeating steps (a) through (c) for each card presented by a customer at the automated banking machine, so that each customer card is operative to cause the browser in the automated banking machine to connect to the server including the at least one document corresponding to the entity with which the customer has their account. LA Times does not explicitly or inherently teach any of these features and therefore does not anticipate claim 12.

Claim 13

Claim 13 depends from claim 12. LA Times does not disclose as further recited, that an automated banking machine includes a display in operative connection with a browser. In addition, LA Times does not disclose documents which include instructions for producing at least one screen uniquely associated with the corresponding entity with which the customer has

his or her account. Further, LA Times does not disclose as recited in the claims that the browser in the automated banking machine is operative responsive to the instructions in the documents, to cause to be produced on the display the at least one screen uniquely associated with the entity with which the customer has their account. LA Times does not explicitly or inherently teach these features and therefore does not anticipate claim 13.

Claim 14

Claim 14 depends from claim 8. Claim 14 further recites charging the account of the customer a transaction fee for using the automated banking machine, and sharing at least a portion of the transaction fee between the entity with which the customer has an account and a further entity which operates the automated banking machine. While LA Times discusses that users or the special machines to trade stocks pay brokerage fees, nothing teaches sharing of such fees between two entities as explicitly recited. LA Times does not explicitly or inherently teach the recited features and therefore does not anticipate claim 14.

Claim 15

Claim 15 depends from claim 8 and further recites accessing with a browser in the machine a plurality of documents from a server associated with an entity with which the customer has the account. Claim 15 further recites accessing with a browser operating in the automated banking machine, at least one advertising document from a further server operated by an advertising entity. In addition, the claim further recites processing the advertising document with a browser to produce advertising content through an output device in operative connection

with the automated banking machine. LA Times mentions nothing about machines that output

advertising content or the other recited features. LA Times does not explicitly or inherently teach

these features and therefore does not anticipate claim 15.

Claim 16

Claim 16 depends from claim 15. Claim 16 further recites making a payment by an

advertising entity to a further entity operating the automated banking machine to compensate the

further entity for having the advertising entity present advertising content on the banking

machine. Where does LA Times discuss outputting advertising through the special machines, let

alone making payments by advertising entity? LA Times does not explicitly or inherently teach

these features and therefore does not anticipate claim 16.

Claim 17

Claim 17 depends from claim 15 and further recites executing the step of accessing with a

browser operating in the automated banking machine, at least one advertising document from a

further server operated by an advertising entity, during the step of accessing with a browser a

plurality of documents from the server associated with the entity with which the customer has the

account. LA Times does not explicitly or inherently teach any of these features and therefore

does not anticipate claim 17.

Claim 18

Claim 18 depends from claim 15. Claim 18 further recites accessing at least one

document with a first browser operating in an automated banking machine, and accessing at least

one document with a second browser operating in the automated banking machine. LA Times teaches nothing about browsers or accessing documents with browsers. LA Times does not explicitly or inherently teach these features and therefore does not anticipate claim 17.

Claim 19

Claim 19 is an independent claim directed to an apparatus. As discussed previously with respect to claims 1 and 8, the assertions in the Action about banking functions that the ATM in LA Times is "considered to perform" and the components that the ATM is "considered to possess" are not supported by the teachings of the reference and are pure speculation by the Office. LA Times is silent as to the available banking functions and components included with the ATM. For example, where does LA Times specifically teach that the ATM is able to provide account access, transfer funds, and dispense statements, especially in 1994?

Appellants respectfully disagree with the Action that the alleged ATM components such as a card reader are inherent in LA Times. Anticipation by inherency requires that the Office establish that persons skilled in the art at the time of the invention would recognize that the missing components are "necessarily present" in the LA Times reference. To establish inherency the Office must prove through citation to prior art that the features alleged to be inherent are "necessarily present" in LA Times. However, there is no teaching or suggestion in LA Times that the described "specially designed automated teller machines" include a card reader or are able to provide account access, transfer funds, and dispense statements. Nor has the Office proved the assertion in the Action, through citation to any prior art, that *every* ATM at the time of the invention included a card reader, and was able to provide account access, transfer funds, and

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dispense statements. That is, the Office has not proved through citation to prior art that the alleged features are "necessarily present" in LA Times. Inherency may not be established based on probabilities or possibilities (which is the present situation). It is plainly improper to reject a claim based merely on the (speculative) possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999).

Nor has the Action established in the prior art what constitutes the Action's alleged "normal components" or "a typical ATM." Nor is there any teaching or suggestion that an ATM in LA Times is "a typical ATM", as alleged. Contrarily, LA Times specifically teaches that the ATM is "specially designed" (i.e., atypical). The limited locations (and thus quantity) of the ATMs also points to their uniqueness. Thus, in light of Appellants' contrary showing, the assertion that LA Times has "a typical ATM" with "normal components" is not legally appropriate.

The Action's assertions are not based on any evidence in the record. An assertion of prior art knowledge not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, supra. The determination of patentability must be based on evidence of record. *In re Lee*, supra. Appellants respectfully submit that because the rejection is based on mere assertions and not proper evidence of record, it is not a valid rejection.

Further, the Action has failed to show where each of the elements, features and relationships recited in claim 19 are taught in LA Times. For example, where does LA Times teach "a plurality of institution servers, each institution server associated with one of a plurality of financial institutions"? In addition, where does LA Times disclose that "each institution

server has at least one unique network address"? Also, where does LA Times disclose that "each institution server is operative to deliver at least one document associated with the respective institution"? Further, where does LA Times disclose or suggest "a network in operative connection with each of the plurality of institution servers"? LA Times says nothing regarding institution servers, network addresses, documents associated with financial institutions, or the other recited features.

In addition, where does LA Times disclose or suggest that "wherein the banking machine includes a computer having a browser operating therein"? The Action admits there is no teaching of an ATM including a browser in LA Times. Also, where does LA Times disclose or suggest that its "specially designed automated teller machines" include a card reader? There is no teaching and no need for a card reader in the special machines as described. Further, where does LA Times disclose or suggest that an "automated banking machine is operative responsive to reading card indicia on a card read by the card reading device, to cause the browser to connect through the network to a network address of an institution server corresponding to the card indicia"? Nowhere does LA Times disclose individually or in combination any of these features recited in claim 19.

Further, as discussed with respect to claim 5 and 8, the Action admits (at page 8, lines 3-4) that LA Times does not disclose an automated banking machine that includes a computer having a browser operating therein. Therefore, by the Action's own admission, LA Times cannot explicitly or inherently teach each of the recited elements, features, and relationships recited in claim 19. For all of these many reasons, LA Times does not anticipate claim 19. Therefore, Appellants respectfully submit that the 35 U.S.C. § 102(b) rejection should be withdrawn.

Claim 20

Claim 20 depends from claim 19. Claim 20 further recites that the browser is operative to process at least one document from an institution server, and to provide an output responsive to the document through an output device on an automated banking machine. LA Times does not explicitly or inherently teach these features and therefore does not anticipate claim 20.

Claim 21

Claim 21 depends from claim 19. LA Times does not disclose or suggest the recited browser in an automated banking machine that is operative to process at least one document from an institution server. In addition, LA Times does not disclose or suggest that the document processed by the browser in the automated banking machine includes at least one instruction for enabling operation of a transaction function device included in the automated banking machine. Further, LA Times does not disclose or suggest as recited in the claim, that the transaction function device is enabled to operate responsive to the browser processing the document. LA Times does not explicitly or inherently teach these features and therefore does not anticipate claim 21.

Claim 22

Claim 22 depends from claim 21 and further recites that the transaction function device includes a sheet dispenser. Claim 21 further recites that a document processed by a browser in an automated banking machine includes at least one sheet dispenser instruction. Claim 22 further recites that the automated banking machine is enabled to dispense at least one sheet responsive to the browser processing the document. LA Times does not disclose or suggest a sheet dispenser

in the described "specially designed automated teller machines". LA Times does not explicitly or inherently teach these features and therefore does not anticipate claim 22.

Claim 23

Claim 23 depends from claim 19 and further recites that card indicia read by the machine includes a BIN number. The claim further recites that the automated banking machine is operative to resolve a network address responsive to the BIN number. LA Times does not explicitly or inherently teach these features, and therefore does not anticipate claim 23.

Claim 24

Claim 24 depends from claim 19. LA Times does not disclose or suggest the recited computer in an automated banking machine which is programmed to operate to cause a browser to access an advertising document from an advertising server. In addition, LA Times does not disclose that the computer of the automated banking machine is operative to output advertising content through the output device of the automated banking machine responsive to the advertising document as explicitly recited. There is not even a mention of advertising content in LA Times. LA Times does not explicitly or inherently teach these features and therefore does not anticipate claim 24.

Claim 25

Claim 25 depends from claim 24. LA Times does not disclose the recited computer in an automated banking machine which is operative to cause a browser to process at least one

document from an institution server, which document includes device instructions. In addition, LA Times does not disclose as expressly recited in claim 25 that a computer in the automated banking machine is adapted to enable a transaction function device of the automated banking machine to operate responsive to the device instructions. Further, LA Times does not disclose or suggest as recited that a computer in an automated banking machine operates to cause advertising content to be output through an output device during operation of the transaction function device. LA Times does not explicitly or inherently teach these features and therefore does not anticipate claim 25.

Claim 26

Claim 26 depends from claim 25. LA Times does not disclose an automated banking machine with a note dispenser as recited. In addition, LA Times does not disclose a computer in an automated banking machine which is adapted to enable a note dispenser of the automated banking machine to operate responsive to the device instructions. Further, LA Times does not disclose a computer in an automated banking machine which operates to cause advertising content to be output through an output device during operation of the note dispenser. LA Times does not explicitly or inherently teach these features and therefore does not anticipate claim 26.

Claim 27

Claim 27 depends from claim 24. LA Times does not disclose as specifically recited, a computer in an automated banking machine which includes a first browser and a second browser operating therein. Further, LA Times does not disclose that the computer in the automated banking machine operates the first browser to access an institution server and the second browser

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to access an advertising server. LA Times does not explicitly or inherently teach these features and therefore does not anticipate claim 27.

Claim 28

Claim 28 is a method claim that depends from claim 1. LA Times does not disclose an automated banking machine which includes a cash dispenser as recited. LA Times does not explicitly or inherently teach this feature and therefore does not anticipate claim 28.

Claim 29

Claim 29 depends from claim 28. LA Times does not disclose or suggest dispensing cash through operation of a cash dispenser. LA Times does not explicitly or inherently teach this feature and therefore does not anticipate claim 29.

Claim 30

Claim 30 depends from claim 8. LA Times does not disclose or suggest an automated banking machine which includes a cash dispenser. LA Times does not explicitly or inherently teach this feature and therefore does not anticipate claim 30.

Claim 31

Claim 31 depends from claim 30. LA Times does not disclose or suggest dispensing cash through operation of a cash dispenser. LA Times does not explicitly or inherently teach this feature and therefore does not anticipate claim 31.

Claim 32

Claim 32 depends from claim 19. LA Times does not disclose or suggest an automated banking machine which comprises a cash dispenser. The functions of the special machines for trading stocks in LA Times makes no mention of and has no use for a cash dispenser. LA Times does not explicitly or inherently teach this feature and therefore does not anticipate claim 32.

The 35 U.S.C. § 103 (a) Rejections

<u>The Applicable Legal Standards</u>

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features and relationships of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Appellants are under no obligation to submit evidence of nonobviousness. MPEP § 2142 (Eighth Edition, August 2001; Rev. 2, May 2004).

The evidence of record must teach or suggest the recited features. An assertion of basic knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

A determination of patentability must be based on evidence of record. *In re Lee*, 277

F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

It is respectfully submitted that the Action from which this appeal is taken does not meet

these burdens.

Rejection under 35 U.S.C. § 103(a) over LA Times

Claims 1-32 were rejected in the alternative under 35 U.S.C. § 103(a) as being

unpatentable over LA Times. These rejections are respectfully traversed.

Claim 1

Claim 1 is an independent claim directed to a method. The Action (Page 6) alleges that

an ATM in LA Times "is considered to perform all the banking functions of a typical ATM, such

as account access, transfer funds, dispense cash, dispense receipts, dispense statements, etc. The

Citibank ATM is also considered to possess all the normal components and component

interrelationships of an ATM machine such as a card reader, currency output device and a

currency sheet dispenser, a receipt output device including a receipt sheet dispenser, etc., and a

computer in operative connection with the output devices and the currency sheet dispensers."

The Appellants respectfully take issue with this assertion.

The functions that the Action asserts the LA Times ATM is "considered to perform" and

features the ATM "considered to possess" are not disclosed or suggested by the reference. The

assertions in the Action are based only on speculation. LA Times contains no teachings

regarding banking functions and components included in the ATM. For example, where does LA

Times specifically teach that the ATM is able to provide account access, transfer funds, and dispense statements, especially in 1994?

Appellants respectfully disagree that the alleged ATM components are inherent in LA Times. Anticipation by inherency requires that the Office establish that persons skilled in the art would recognize that the missing components are "necessarily present" in the LA Times reference. To establish inherency the Office must prove through citation to prior art, that the features alleged to be inherent are "necessarily present" in LA Times. However, there is no teaching or suggestion in LA Times that the ATM is able to provide account access, transfer funds, and dispense statements. Nor has the Office proved the assertion in the Action that *every* ATM is able to provide account access, transfer funds, and dispense statements. That is, the Office has not proved through citation to prior art, that the alleged features are "necessarily present" in LA Times. Inherency may not be established based on probabilities or possibilities (which is the present situation). It is plainly improper to reject a claim based merely on the (speculative) possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999).

Nor has the Action established through citation to prior art what constitutes the alleged "normal components" or "a typical ATM" at the time of the effective filing date of the present application. Nor is there any teaching or suggestion that an ATM in LA Times is "a typical ATM", as alleged. Contrarily, LA Times specifically teaches that the ATM is "specially designed" (i.e., atypical). The limited locations (and thus quantity) of the ATMs also points to

their uniqueness. Thus, in light of Appellants' contrary showing, the assertion in the Action that

LA Times has "a typical ATM" with "normal components" is not legally appropriate.

The Action's assertions are not based on any evidence in the record. An assertion of prior

art knowledge not based on any evidence in the record lacks substantial evidence support. *In re*

Zurko, supra. The determination of patentability must be based on evidence of record. *In re Lee*,

supra. Appellants respectfully submit that because the rejection is based on mere assertions and

not proper evidence of record, it is not a legally valid rejection.

Further, the Action has failed to show where each of the method steps recited in claim 1

is shown in LA Times. For example, where does LA Times disclose or suggest "determining

through operation of an automated banking machine, data corresponding to an entity with which

a customer operating the machine has an account"? LA Times is totally devoid of any teaching

that the machine determines data corresponding to an entity. Further, nothing in LA Times

suggests that the machine described operates to determine such data corresponding to an entity

with which the user has an account. There is no teaching or suggestion in LA Times that these

"special" machines can be operated by anyone other than a Citibank customer. Therefore, there

is no need for such a machine to determine data corresponding to an entity with which the

operator of the machine has an account. The Action contains no prior art showing that LA Times

teaches or suggests these recited features.

Where does LA Times disclose or suggest "providing through an output device on the

automated banking machine at least one output uniquely corresponding to the entity with which

the customer has the account" as specifically recited in claim 1? Nowhere does LA Times

disclose or suggest providing such an output corresponding to such an entity based on machine

determined data. LA Times states that its "specially designed automated teller machines have separate menus for banking and brokerage services". However, nowhere does LA Times disclose or suggest providing an output which uniquely corresponds to an entity with which the customer has an account. Nor are the recited steps inherent in LA Times. LA Times does not teach or suggest providing an output from the machine uniquely corresponding to any entity, let alone an entity that corresponds to data determined by the machine as the entity with which the customer has an account, as specifically recited.

Nor are the recited features inherent in the teachings of LA Times. The Office has not shown through citation to prior art evidence that the recited steps are "necessarily present" in LA Times. Nor has the Office provided any evidence that supports the Action's assertion that *every* ATM at the time of the effective filing date of the present application performs the recited steps.

LA Times does not explicitly or inherently teach or suggest each of the recited features, relationships, and steps. The Action's assertions are not based on any prior art evidence. Thus a *prima facie* case of obviousness has not been established. Therefore, Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection should be reversed.

Claim 2

Claim 2 depends from claim 1. LA Times does not disclose or suggest the further recited feature of reading indicia with a reading device in operative connection with an automated banking machine. LA Times makes no mention of any type of reading device. The Office has not established *prima facie* obviousness with respect to claim 2, and it is respectfully submitted the rejection should be reversed.

Claim 3

Claim 3 depends from claim 2. LA Times does not disclose or suggest reading indicia on a card with a card reader in connection with an automated banking machine. LA Times makes no mention of a card reader. Thus the Office has not established *prima facie* obviousness with respect to claim 3.

Claim 4

Claim 4 depends from claim 1. LA Times does not disclose or suggest the further recited feature of providing at least one visual output corresponding to the entity with which the customer has the account through the output device. LA Times discloses or suggests nothing about outputs associated with such an entity as determined through operation of the machine, let alone a visual output. Thus the Office has not established *prima facie* obviousness with respect to claim 4.

Claim 5

Claim 5 depends from claim 4. LA Times does not disclose or suggest the further recited features of processing at least one document through a browser operating in a computer in operative connection with an automated banking machine. Further the Action admits (at page 8, lines 3-4) that LA Times does not disclose this feature. Thus the Office has not established *prima facie* obviousness with respect to claim 5.

Claim 6

Claim 6 depends from claim 5. LA Times does not disclose or suggest the further recited features of providing at least one output responsive to a document (processed through a browser), that is determined responsive to data corresponding to an entity with which the customer has the account, which data is determined through operation of an automated banking machine. The Action includes no showing that the cited reference discloses or suggests these recited features. Thus the Office has not established *prima facie* obviousness with respect to claim 6.

Claim 7

Claim 7 depends from claim 6. LA Times does not disclose or suggest the further recited features of accessing the at least one document at a system address, wherein the system address is determined responsive to data corresponding to an entity with which the customer has the account, which data is determined through operation of an automated banking machine. Thus the Office has not established *prima facie* obviousness with respect to claim 7.

Claim 8

Claim 8 is an independent claim directed to a method. As discussed previously with respect to claim 1, the banking functions the Action asserts the ATM in LA Times is "considered to perform", and the components that the ATM is "considered to possess" are neither suggested nor disclosed by the reference or any other cited art. It is respectfully submitted that these rejections are based only on unsupported speculation. LA Times is silent as to the available banking functions and components included with the "specially designed" ATM. For example,

where does LA Times specifically teach that the ATM is able to provide account access, transfer funds, and dispense statements, especially in 1994?

Appellants respectfully disagree that the alleged ATM components such as a card reader are inherent in LA Times. An assertion of inherency requires that the Office establish that persons skilled in the art would recognize that the missing components are "necessarily present" in the LA Times reference. To establish inherency the Office must prove through citation to prior art, that the features alleged to be inherent are "necessarily present" in LA Times.

There is no teaching or suggestion in LA Times that the described "specially designed automated teller machines" include a card reader, or are able to provide account access, transfer funds, and dispense statements. Nor has the Office supported by citation to prior art, the assertion in the Action that *every* ATM at the time of the effective filing date included a card reader, and was able to provide account access, transfer funds, and dispense statements. That is, the Office has not proved through citation to prior art that the alleged features are "necessarily present" in LA Times. Indeed, nothing prevents the "specially designed" Citibank machines from operating without the use of a card reader, such as by input by each customer of the customer's brokerage account number, for example. Inherency may not be established based on probabilities or possibilities (which is the present situation). It is plainly improper to reject a claim based merely on the (speculative) possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999).

Nor has the Action established in the prior art what constitutes the alleged "normal components" or "a typical ATM." Nor is there any teaching or suggestion that an ATM in LA

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Times is "a typical ATM", as alleged. Contrarily, LA Times specifically teaches that the ATM is "specially designed" (i.e., atypical). The limited locations (and thus quantity) of the ATMs also points to their uniqueness. Thus, in light of Appellants' contrary showing, the assertion that LA Times has "a typical ATM" with "normal components" is not legally supported and runs directly counter to the explicit teachings of the reference.

The Action's assertions are not based on any evidence in the record. An assertion of prior art knowledge not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, supra. The determination of patentability must be based on evidence of record. *In re Lee*, supra. Appellants respectfully submit that because the rejection is based on mere assertions and not proper evidence of record, it is not a valid rejection.

Further, the Action has failed to show where each of the method steps recited in claim 8 are shown in LA Times. For example where does LA Times disclose or suggest "reading card indicia on a card presented by a customer to an automated banking machine, the card indicia including entity data corresponding to an entity with which the customer has an account"? LA Times is devoid of any such teaching or suggestion of these features.

In addition, where does LA Times disclose or suggest "resolving network address data with the banking machine responsive to the entity data and data stored in a data store"? LA Times teaches or suggests nothing about a machine resolving network address data. LA Times further says nothing about resolving data responsive to data on a card and data in a data store.

Where does LA Times disclose or suggest "operating a browser in the banking machine responsive to the resolved network address data, to access at least one network address in a

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network"? LA Times makes no mention of a browser or accessing resolved network address data.

Where does LA Times disclose or suggest that "the network address accessed corresponds to an address of a server adapted to deliver documents corresponding to the entity with which the customer has the account"? Where does LA Times discuss a server that delivers documents, such as HTML documents?

Nowhere does LA Times disclose or suggest individually or in combination, these steps which are specifically recited in claim 8.

As discussed with respect to claim 5, the Action admits (at page 8, lines 3-4) that LA Times does not disclose operating a browser in an automated banking machine. Therefore, by the Action's own admission, LA Times can not explicitly or inherently teach each of the recited features, relationships, and steps recited in claim 8.

For all these reasons, it is submitted that a *prima facie* case of obviousness has not been established. Therefore, Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection should be reversed.

Claim 9

Claim 9 depends from claim 8. LA Times does not disclose or suggest the further recited features of processing at least one document corresponding to the entity with which the customer has the account, from the server, and providing at least one output through an output device of an automated banking machine responsive to the at least one document. Nothing in the cited art

discloses or suggests these features. Thus the Office has not established *prima facie* obviousness with respect to claim 9.

Claim 10

Claim 10 depends from claim 9. LA Times does not disclose or suggest the additionally recited features of providing at least one visual output through a display of an automated banking machine responsive to a document corresponding to an entity with which the customer has an account. Thus the Office has not established *prima facie* obviousness with respect to claim 10.

Claim 11

Claim 11 depends from claim 8. LA Times does not disclose or suggest the further recited feature of processing the first document with a browser in the automated banking machine. In addition, LA Times does not disclose or suggest operating the transaction function device of the banking machine responsive to the at least one instruction in the first document as expressly recited. The Action admits the absence of any teaching of the use of browser software in LA Times. Certainly, no teaching or suggestion is provided of a browser that process instructions included in documents that cause operation of a transaction function device of the machine. Thus the Office has not established *prima facie* obviousness with respect to claim 11.

Claim 12

Claim 12 depends from claim 8. LA Times does not disclose or suggest the further recited steps of providing a plurality of servers, one for each of a plurality of entities with which

a plurality of users of the automated banking machine have accounts. In addition, LA Times does not disclose or suggest as further recited that each server is in operative connection with a network, has a corresponding network address, and is adapted to deliver at least one document corresponding to the entity with which it is associated. Further, LA Times does not disclose or suggest repeating steps (a) through (c) for each card presented by a customer at the automated banking machine. In addition, LA Times does not disclose or suggest that each customer card is operative to cause the browser in the automated banking machine to connect to the server including the at least one document corresponding to the entity with which the customer has their account. The cited art fails to suggest any of these recited features. Thus the Office has not established *prima facie* obviousness with respect to claim 12.

Claim 13

Claim 13 depends from claim 12. LA Times does not disclose or suggest that an automated banking machine includes a display in operative connection with a browser as recited. In addition, LA Times does not disclose or suggest documents which include instructions for producing at least one screen uniquely associated with the corresponding entity with which the customer has their account. Further, LA Times does not disclose or suggest that the browser in the automated banking machine is operative responsive to the instructions in the documents to cause to be produced on the display, the at least one screen uniquely associated with the entity with which the customer has their account. As all of these features are not disclosed or suggested in the cited art, the Office has not established *prima facie* obviousness with respect to claim 13.

Claim 14

Claim 14 depends from claim 8. LA Times does not disclose or suggest the further recited features of charging the account of the customer a transaction fee for using the automated banking machine and sharing at least a portion of the transaction fee between the entity with which the customer has an account and a further entity which operates the automated banking machine. While LA Times discusses charging a brokerage fee to users of the special machines to trade stocks, nothing in LA Times teaches or suggests sharing such fees between plural entities as recited. Thus the Office has not established *prima facie* obviousness with respect to claim 14.

Claim 15

Claim 15 depends from claim 8. LA Times does not disclose or suggest accessing with a browser a plurality of documents from a server associated with an entity with which the customer has the account as further recited. LA Times also does not disclose or suggest accessing with a browser operating in an automated banking machine, at least one advertising document from a further server operated by an advertising entity. In addition, LA Times does not disclose or suggest processing the advertising document with a browser to produce advertising content through an output device in operative connection with the automated banking machine. LA Times teaches or suggests nothing about machines that output advertising content, or any of the other additional recited features. Thus the Office has not established *prima facie* obviousness with respect to claim 15.

Claim 16

Claim 16 depends from claim 15. LA Times does not disclose or suggest making a payment by an advertising entity to a further entity operating the automated banking machine to compensate the further entity for having the advertising entity present advertising content on the banking machine as further recited. LA Times provides no pertinent teaching related to these features. Thus the Office has not established *prima facie* obviousness with respect to claim 16.

Claim 17

Claim 17 depends from claim 15. LA Times does not disclose or suggest the additionally recited features of executing a step of accessing with a browser operating in the automated banking machine, at least one advertising document from a further server operated by an advertising entity during a step of accessing with a browser a plurality of documents from the server associated with the entity with which the customer has the account. Thus the Office has not established *prima facie* obviousness with respect to claim 17.

Claim 18

Claim 18 depends from claim 15. LA Times does not disclose or suggest the further recited features of accessing at least one document with a first browser operating in an automated banking machine, and accessing at least one document with a second browser operating in the automated banking machine. The Action admits LA Times does not teach or suggest one browser. It clearly does not suggest two browsers in combination with the other recited features. Thus the Office has not established *prima facie* obviousness with respect to claim 18.

Claim 19

Claim 19 is an independent claim directed to an apparatus. As discussed previously with respect to claims 1 and 8, the assertions in the Action about banking functions that the ATM in LA Times is "considered to perform" and the components that the ATM is "considered to possess" are neither disclosed nor suggested by the reference nor any other cited art. LA Times is silent as to the available banking functions and components included in the "specially designed" ATMs. For example, where does LA Times specifically teach that the ATM is able to provide account access, transfer funds, and dispense statements, especially in 1994?

Appellants respectfully disagree with the Action that the alleged ATM components such as a card reader are inherent in LA Times. Anticipation by inherency requires that the Office establish that persons skilled in the art at the time of the invention would recognize that the missing components are "necessarily present" in the LA Times reference. To establish inherency the Office must prove through citation to prior art that the features alleged to be inherent are "necessarily present" in LA Times. However, there is no teaching or suggestion in LA Times that the described "specially designed automated teller machines" include a card reader or is able to provide account access, transfer funds, and dispense statements. Nor has the Office proved through citation to prior art the assertion in the Action that *every* ATM at the time of the invention included a card reader, and was able to provide account access, transfer funds, and dispense statements. That is, the Office has not proved through citation to prior art that the alleged features are "necessarily present" in LA Times. Inherency may not be established based on probabilities or possibilities (which is the present situation). It is plainly improper to reject a claim based merely on the (speculative) possibility that a particular prior art disclosure could or

might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999).

Nor has the Action established in the prior art what constitutes the Action's alleged "normal components" or "a typical ATM." Nor is there any teaching or suggestion that an ATM in LA Times is "a typical ATM", as alleged. Contrarily, LA Times specifically teaches that the ATM is "specially designed" (i.e., atypical). The limited locations (and thus quantity) of the ATMs also points to their uniqueness. Thus, in light of Appellants' contrary showing, the assertion that LA Times has "a typical ATM" with "normal components" is not legally appropriate.

The Action's assertions are not based on any evidence in the record. An assertion of prior art knowledge not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, supra. The determination of patentability must be based on evidence of record. *In re Lee*, supra. Appellants respectfully submit that because the rejection is based on mere assertions and not proper evidence of record, it is not a valid rejection.

Further, the Action has failed to show where each of the elements, features and relationships recited in claim 19 are taught or suggested in LA Times. For example, where does LA Times disclose or suggest "a plurality of institution servers, each institution server associated with one of a plurality of financial institutions"? In addition, where does LA Times disclose or suggest that "each institution server has at least one unique network address"? Also, where does LA Times disclose or suggest that "each institution server is operative to deliver at least one document associated with the respective institution"? Further, where does LA Times disclose or

suggest "a network in operative connection with each of the plurality of institution servers"? There are no teachings or suggestions of these features in LA Times or in any other cited art.

In addition, where does LA Times disclose or suggest that "wherein the banking machine includes a computer having a browser operating therein"? Rather, the Action admits LA Times has no such teaching. Also, where does LA Times disclose or suggest that its "specially designed automated teller machines" include a card reader? There is no need for one in the "specially designed" machines described in LA Times. LA Times ATMs may operate based on manual inputs of a brokerage account number or other inputs not requiring a card reader. Further, where does LA Times disclose or suggest that an "automated banking machine is operative responsive to reading card indicia on a card read by the card reading device, to cause the browser to connect through the network to a network address of an institution server corresponding to the card indicia"? Nowhere does LA Times disclose or suggest individually or in combination these features and relationships recited in claim 19.

Further, as discussed with respect to claims 5 and 8, the Action admits (at page 8, lines 3-4) that LA Times does not disclose an automated banking machine that includes a computer having a browser operating therein. Therefore, by the Action's own admission, LA Times can not explicitly or inherently teach each of the recited elements, features, and relationships recited in claim 19.

A *prima facie* case of obviousness against claim 19 has not been established. Therefore, Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection should be reversed.

Claim 20

Claim 20 depends from claim 19. LA Times does not disclose or suggest the further recited features of a browser operative to process at least one document from an institution server, and to provide an output responsive to the document through an output device on an automated banking machine. Thus the Office has not established *prima facie* obviousness with respect to claim 20.

Claim 21

Claim 21 depends from claim 19. LA Times does not disclose or suggest a browser in an automated banking machine that is operative to process at least one document from an institution server as specifically recited. In addition, LA Times does not disclose or suggest that the document processed by the browser in the automated banking machine includes at least one instruction for enabling operation of a transaction function device included in the automated banking machine. Further, LA Times does not disclose or suggest that the transaction function device is enabled to operate responsive to the browser processing the document. Thus the Office has not established *prima facie* obviousness with respect to claim 21.

Claim 22

Claim 22 depends from claim 21. LA Times does not disclose or suggest a document processed by a browser in an automated banking machine, which document includes at least one sheet dispenser instruction, as recited. Further, LA Times does not disclose or suggest an automated banking machine which includes a sheet dispenser and which is enabled to dispense at

least one sheet responsive to the browser processing the document. LA Times does not disclose or suggest, nor is there any purpose for, a sheet dispenser in the "specially designed" machines of LA Times. Thus the Office has not established *prima facie* obviousness with respect to claim 22.

Claim 23

Claim 23 depends from claim 19. LA Times does not disclose or suggest as recited, an automated banking machine which is operative to resolve a network address responsive to a BIN number included in card indicia read from a card. Thus the Office has not established *prima facie* obviousness with respect to claim 23.

Claim 24

Claim 24 depends from claim 19. LA Times does not disclose or suggest a computer in an automated banking machine which is programmed to operate to cause a browser to access an advertising document from an advertising server. LA Times also does not disclose or suggest that the computer of the automated banking machine is operative to output advertising content through the output device of the automated banking machine responsive to the advertising document. No mention is made of any output of advertising content in the machines of LA Times. Thus the Office has not established *prima facie* obviousness with respect to claim 24.

Claim 25

Claim 25 depends from claim 24. LA Times does not disclose or suggest a computer in an automated banking machine which is operative to cause a browser to process at least one

document from an institution server, which document includes device instructions. In addition, LA Times does not disclose or suggest that a computer in the automated banking machine is adapted to enable a transaction function device of the automated banking machine to operate responsive to the device instructions. Further, LA Times does not disclose or suggest a computer in an automated banking machine which operates to cause advertising content to be output through an output device during operation of the transaction function device. Thus the Office has not established *prima facie* obviousness with respect to claim 25.

Claim 26

Claim 26 depends from claim 25. LA Times does not disclose or suggest an automated banking machine with a note dispenser. In addition, LA Times does not disclose or suggest a computer in an automated banking machine which is adapted to enable a note dispenser of the automated banking machine to operate responsive to the device instructions. Further, LA Times does not disclose or suggest a computer in an automated banking machine which operates to cause advertising content to be output through an output device during operation of the note dispenser. LA Times discloses or suggests nothing with regard to these recited features. Thus the Office has not established *prima facie* obviousness with respect to claim 26.

Claim 27

Claim 27 depends from claim 24. LA Times does not disclose or suggest a computer in an automated banking machine which includes a first browser and a second browser operating therein. Further, LA Times does not disclose or suggest that the computer in the automated

banking machine operates the first browser to access an institution server and the second browser to access an advertising server. The Office has not established *prima facie* obviousness with respect to claim 27.

Claim 28

Claim 28 depends from claim 1 and further recites a cash dispenser. LA Times does not disclose or suggest an automated banking machine which includes a cash dispenser. LA Times' "specially designed" machine has no use for a cash dispenser. Thus the Office has not established *prima facie* obviousness with respect to claim 28.

Claim 29

Claim 29 depends from claim 28 and further recites a cash dispenser. LA Times does not disclose or suggest dispensing cash through operation of a cash dispenser. Thus the Office has not established *prima facie* obviousness with respect to claim 29.

Claim 30

Claim 30 depends from claim 8. LA Times does not disclose or suggest an automated banking machine which includes a cash dispenser. Thus the Office has not established *prima facie* obviousness with respect to claim 30.

Claim 31

Claim 31 depends from claim 30. LA Times does not disclose or suggest dispensing cash through operation of a cash dispenser. Thus the Office has not established *prima facie* obviousness with respect to claim 31.

Claim 32

Claim 32 depends from claim 19. LA Times does not disclose or suggest an automated banking machine which comprises a cash dispenser. Thus the Office has not established *prima facie* obviousness with respect to claim 32.

Rejection under 35 U.S.C. § 103(a) over LA Times in view of either Infoworld or Anderson

Claims 1-32 were rejected in the alternative under 35 U.S.C. § 103(a) as being

unpatentable over LA Times in view of Infoworld or Anderson. These rejections are respectfully

traversed.

Claim 1

Claim 1 is an independent claim directed to a method. The Action (Page 6) alleges that

an ATM in LA Times "is considered to perform all the banking functions of a typical ATM, such

as account access, transfer funds, dispense cash, dispense receipts, dispense statements, etc. The

Citibank ATM is also considered to possess all the normal components and component

interrelationships of an ATM machine such as a card reader, currency output device and a

currency sheet dispenser, a receipt output device including a receipt sheet dispenser, etc., and a

computer in operative connection with the output devices and the currency sheet dispensers."

The Appellants respectfully take issue with these assertions.

The banking functions that the Action asserts the ATM of LA Times is "considered to

perform" and the asserted components that the ATM is "considered to possess" are not based on

any evidence of record and constitute pure speculation by the Office. LA Times contains no

teachings regarding banking functions and components included in the ATM. For example,

where does LA Times specifically teach that the ATM is able to provide account access, transfer

funds, and dispense statements, especially in 1994?

Appellants respectfully disagree that the alleged ATM components are inherent in LA Times. Anticipation by inherency requires that the Office establish that persons skilled in the art would recognize that the missing components are "necessarily present" in the LA Times reference. To establish inherency the Office must prove through citation to prior art that the features alleged to be inherent are "necessarily present" in LA Times. However, there is no teaching or suggestion in LA Times that the ATM is able to provide account access, transfer funds, and dispense statements. Nor has the Office proved the assertion in the Action that *every* ATM is able to provide account access, transfer funds, and dispense statements. That is, the Office has not proved through citation to prior art, that the alleged features are "necessarily present" in LA Times. Inherency may not be established based on probabilities or possibilities (which is the present situation). It is plainly improper to reject a claim based merely on the (speculative) possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999).

Nor has the Action established through citation to prior art what constitutes the alleged "normal components" or "a typical ATM" at the time of the effective filing date of the present application. Nor is there any teaching or suggestion that an ATM of LA Times is "a typical ATM", as alleged. Contrarily, LA Times specifically teaches that the ATM is "specially designed" (i.e., atypical). The limited locations (and thus quantity) of the ATMs also points to their uniqueness. Thus, in light of Appellants' contrary showing, the assertion in the Action that LA Times has "a typical ATM" with "normal components" is not legally appropriate.

The Action's assertions are not based on any evidence in the record. An assertion of prior art knowledge not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, supra. The determination of patentability must be based on evidence of record. *In re Lee*, supra. Appellants respectfully submit that because the rejection is based on mere assertions and not proper evidence of record, it is not a legally valid rejection.

Further, the Action has failed to show where each of the method steps recited in claim 1 are taught or suggested in LA Times and either InfoWorld or Anderson. As the Action has made no effort to apply the teachings of the cited references to what is recited in claim 1, Appellants reserve their rights to rebut any more specific assertions in reply to the Examiner's Answer. However, it is apparent that the references do not teach or suggest the recited features. For example, where do LA Times, Infoworld or Anderson disclose or suggest "determining through operation of an automated banking machine, data corresponding to an entity with which a customer operating the machine has an account"? In addition, where do LA Times, Infoworld or Anderson disclose or suggest, in addition to determining data corresponding to such entity with the banking machine, "providing through an output device on the automated banking machine at least one output uniquely corresponding to the entity with which the customer has the account"? Nowhere do LA Times, Infoworld or Anderson discloses or suggest, either individually or in combination, these features, relationships and steps specifically recited in claim 1.

LA Times states that its "specially designed automated teller machines have separate menus for banking and brokerage services". However, nowhere does LA Times disclose or suggest providing an output which uniquely corresponds to the entity with which the customer has an account. Nor does LA Times teach or suggest providing an output from the machine

uniquely corresponding to any entity, let alone an entity that corresponds to data determined by

the machine as the entity with which the user has an account, as specifically recited. As

previously discussed, the "specially designed" machines for Citibank customers have no use for

any such features. There is no valid basis for the Action's assertions that such features are

somehow taught or suggested.

Nor are the recited features inherent in the teachings of LA Times. The Office has not

proved through citation to any prior art that the recited steps are "necessarily present" in LA

Times. Nor has the Office provided any evidence to support the Action's assertion that *every*

ATM at the time of the effective filing date of the present application performs the recited steps.

Neither Infoworld nor Anderson show the recited features, relationships and steps in

claim 1 which are missing from LA Times. For example, nowhere does Infoworld disclose or

suggest how the automated teller machine mentioned in the article operates. Nowhere does

Infoworld disclose or suggest that an automated banking machine determines data corresponding

to an entity with which a customer operating the machine has an account, and provides through

an output device of the machine at least one output uniquely corresponding to the entity with

which the customer has the account. The Action does not provide any showing that these

secondary references teach any of the features specifically recited in claim 1.

Anderson does not disclose or suggest an ATM or an automated banking machine. Nor is

there any teaching or suggestion in Anderson that any of its described features are usable with or

analogous to an ATM or automated banking machine. Further, even if it were possible (which it

is not) for any of the described features in Anderson to correspond to an ATM or an automated

banking machine, nowhere does Anderson disclose or suggest the method steps recited in claim

1. For example, nowhere does Anderson disclose or suggest as recited in claim 1, that an automated banking machine determines data corresponding to an entity with which a customer operating the machine has an account, and provides through an output device of the machine at least one output uniquely corresponding to the entity with which the customer has the account.

LA Times, Infoworld and Anderson do not disclose or suggest each of the features, relationships and steps recited in the claim. A *prima facie* case of obviousness has not been established because the relied upon references do not teach or suggest all of the claim features, relationships and steps. The Office has not met the burden of establishing *prima facie* obviousness. It follows that the rejection is not legally valid and should be reversed.

The Action is also silent as to how the LA Times teaching could be modified by the teachings of either Infoworld or Anderson, to perform the steps recited in claim 1. Nor has any evidence been presented that LA Times is structurally and functionally capable of being modified by the teaching of either Infoworld or Anderson to produce the recited invention. For example, the Action has not shown that or explained how NCR's alleged ATM technology (Infoworld) may be combined or used with Citibank's ATM technology (LA Times). Nor has the Action shown that or explained how Anderson's "Conductor system" architecture may be combined or used with Citibank's ATM technology (LA Times). Nor has the Action presented any valid prior art motivation to combine features in the references. Since the Action does not explain the rejection with reasonable specificity, it also procedurally fails to establish a *prima facie* case of obviousness. *Ex parte Blanc*, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989). Thus it would not have been obvious to one having ordinary skill in the art at the time of the present invention to have modified LA Times with the teachings of either Infoworld or Anderson as alleged.

Furthermore, even if it were somehow possible to modify the system of LA Times with the teachings of either Infoworld or Anderson as alleged, such modification still would not have resulted in the features and relationships as recited in claim 1. The resulting modified LA Times still would not teach or suggest an automated banking machine that determines what institution has a customer's account and provides outputs uniquely corresponding to that entity.

For example, even if it were somehow possible to modify the system of LA Times (1994) with the teaching of Infoworld (which it isn't) it would have at best resulted in use of the Top End monitoring program of Infoworld in connection with an ATM. However, Infoworld (beginning in July 1996) already teaches use of the Top End transaction processing monitor in connection with an ATM. Thus modification (if somehow possible) of LA Times with the teachings of Infoworld would not have produced the recited invention. Thus it would not have been obvious to one having ordinary skill in the art to have modified LA Times with the teachings of Infoworld to have produced the recited invention.

Also for example, even if it were somehow possible to modify the system of LA Times with the teachings of Anderson (which it isn't) it would have at best resulted in providing Anderson's services such as checking an account balance, with a customer's PC. Thus modification of LA Times with the teachings of Anderson would also not have produced the recited invention. Thus it would not have been obvious to one having ordinary skill in the art to have modified LA Times with the teachings of Anderson to have produced the recited invention.

The attempts to combine the alleged teachings are clearly nothing more than attempts at hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 22 USPQ2d 1780 (Fed. Cir. 1992). However, the cited references do not teach all the features recited in the claim

nor any desirability or any motivation for making the recited combination. The rejections, which lack the necessary evidence and rationale, are based on knowledge gleaned only from Appellants' disclosure.

None of the relied upon references, taken alone or in combination, discloses or suggests the features and relationships that are specifically recited in claim 1. A *prima facie* case of obviousness has not been established. Furthermore, as previously discussed, it would not have been obvious to one having ordinary skill in the art to have combined features of the references as alleged. The applied prior art is devoid of any such teaching, suggestion, or motivation for combining features of the references so as to produce the recited invention. Nevertheless, even if it were somehow possible for the references to be combined as alleged, the resultant combination still would not have resulted in the claimed invention. Therefore, Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection should be reversed.

Claim 2

Claim 2 depends from claim 1. LA Times, Infoworld and Anderson do not disclose or suggest reading indicia with a reading device in operative connection with an automated banking machine. Thus the Office has not established *prima facie* obviousness with respect to claim 2.

Claim 3

Claim 3 depends from claim 2. LA Times, Infoworld and Anderson do not disclose or suggest reading indicia on a card with a card reader in connection with an automated banking machine. Thus the Office has not established *prima facie* obviousness with respect to claim 3.

Claim 4

Claim 4 depends from claim 1. LA Times, Infoworld and Anderson do not disclose or suggest providing at least one visual output corresponding to the entity with which the customer has the account through an output device of the automated banking machine. Thus the Office has not established *prima facie* obviousness with respect to claim 4.

Claim 5

Claim 5 depends from claim 4. LA Times, Infoworld and Anderson do not disclose or suggest providing an output through the banking machine by processing at least one document, such as an HTML document, through a browser operating in a computer in operative connection with an automated banking machine. The Action incorrectly asserts that Infoworld teaches a Web browser interface on an ATM. However, as the Board correctly noted when it construed this same reference in Appeal No. 2004-1824, the browser interface in Inforworld resides on a back office system (away from the ATM or cash register). Neither Inforworld nor Anderson discloses or suggests operating a browser on a computer in an automated banking machine to provide an output from the banking machine. These references further do not teach or suggest processing a document through such a browser to provide a visual output from the banking machine uniquely corresponding to the entity with which a user of the banking machine has an account, as specifically recited. Thus the Office has not established *prima facie* obviousness with respect to claim 5.

Claim 6

Claim 6 depends from claim 5. LA Times, Infoworld and Anderson further do not

disclose or suggest a document (processed through a browser) that is determined responsive to

data corresponding to an entity with which the customer has the account, which data is

determined through operation of an automated banking machine. Thus the Office has not

established *prima facie* obviousness with respect to claim 6.

Claim 7

Claim 7 depends from claim 6. LA Times, Infoworld and Anderson do not disclose or

suggest accessing the at least one document at a system address, wherein the system address is

determined responsive to data corresponding to an entity with which the customer has the

account, which data is determined through operation of an automated banking machine. Thus the

Office has not established *prima facie* obviousness with respect to claim 7.

Claim 8

Claim 8 is an independent claim directed to a method. As discussed previously with

respect to claim 1, the assertions in the Action about banking functions that the ATM in LA

Times is "considered to perform" and the components that the ATM is "considered to possess"

are pure speculation by the Office. LA Times is silent as to the available banking functions and

components included with the ATM. For example, where does LA Times specifically teach that

the ATM is able to provide account access, transfer funds, and dispense statements, especially in

1994?

Appellants respectfully disagree that the ATM components the Action attributes to the references, such as a card reader, are inherent in LA Times. Anticipation by inherency requires that the Office establish that persons skilled in the art would recognize that the missing components are necessarily present in the LA Times reference. To establish inherency the Office must prove through citation to prior art that the features alleged to be inherent are "necessarily present" in LA Times. However, there is no teaching or suggestion in LA Times that the described "specially designed automated teller machines" include a card reader or are able to provide account access, transfer funds, and dispense statements. Nor has the Office proved that every ATM includes a card reader, and is able to provide account access, transfer funds, and dispense statements. That is, the Office has not proved through citation to prior art that the alleged features are "necessarily present" in LA Times. Indeed, the "specially designed" ATMs of LA Times may operate in response to manual inputs of brokerage account number or other type of inputs not involving a card reader. Inherency may not be established based on probabilities or possibilities (which is the present situation). It is plainly improper to reject a claim based merely on the (speculative) possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999).

Nor has the Action established in the prior art what constitutes the alleged "normal components" or "a typical ATM." Nor is there any teaching or suggestion that an ATM in LA Times is "a typical ATM", as alleged. Contrarily, LA Times specifically teaches that the ATM is "specially designed" (i.e., atypical). The limited locations (and thus quantity) of the ATMs also

points to their uniqueness. Thus, in light of Appellants' contrary showing, the assertion that LA Times has "a typical ATM" with "normal components" is not legally appropriate.

The Action's assertions are not based on any evidence in the record. An assertion of prior art knowledge not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, supra. The determination of patentability must be based on evidence of record. *In re Lee*, supra. Appellants respectfully submit that because the rejection is based on mere assertions and not proper evidence of record, it is not a valid rejection.

The Action (at page 8, lines 3-4) admits that LA Times does not teach or suggest the user interface at the ATM being a Web browser interface. That is, the Action admits that LA Times does not teach or suggest an ATM operating through use of browser software. The Appellants respectfully submit that LA Times also does not teach or suggest an ATM that is able to receive documents, such as HTML documents, as recited in the claim.

Contrarily, the limited geographical locations for the ATMs in LA Times appear to point to the system as being locally based with conventional prior art communications and programming, rather than Web-based. Nor is there any teaching or suggestion of LA Times ATMs resolving network address data, as recited in the claim. Nor is there any teaching or suggestion in LA Times that an ATM needs or could operate with a browser, as recited. Additionally, the device described in LA Times distinguishes and keeps separate the brokerage services from banking services offered to users. Furthermore, even if it were somehow possible for the ATM to receive documents from a server using a browser operating in the ATM (which it isn't), there would still be no teaching or suggestion to have a browser in an automated banking machine be responsive to resolved network address data to access at least one network address in

a network, wherein the network address accessed corresponds to an address of a server adapted to deliver documents corresponding to the entity with which the customer has the account (as specifically recited in claim (8).

The Action alleges that in Infoworld a "browser interface is the interface through which all the ATM banking functions of the NCR ATM machine are performed, such as account access, funds transfer, the dispensing of currency and receipts responsive to the interaction of the user with the Web browser interface." The Appellants respectfully wish to point out that these assertions are not correct.

Infoworld does not teach or suggest such features. For example, where does Infoworld teach or suggest that ATM banking functions are performed through a browser interface? Where does Infoworld teach or suggest that Top End carries out and controls the ATM transactions? Rather, Infoworld is directed to a TP monitoring program that monitors or tracks transactions. Apparently, Top End (similar to present day TP monitors) ensures that each monitored transaction gets completed or is fully rolled back. Top End provides a Web browser interface on a remote back end transaction processing system that is away from any ATM. In Infoworld, client software (not involving a browser) runs on cash registers and ATMs. This client software transmits transaction data to a remote "back end" processing system which includes the Web browser.

Appellants respectfully submit that the Action takes the Infoworld language out of context. Infoworld does not state that it enables ATM transactions over the Web to make one or 10,000 machines look as if they are local to a computing resource, as alleged in the Action. Contrarily, Infoworld teaches that the "one or 10,000 machines" comment is directed to the Top

End program reporting transactions to a back-end accounting system. Infoworld admits that NCR is still "trying to overcome" limitations "to enable" transactions over the Web. Thus Infoworld specifically indicates that it is not capable of carrying out ATM transactions over the Web.

Furthermore, the system described in Infoworld describes credit card transactions being controlled and performed through a conventional proprietary transaction network, with the account balancing transfers being monitored and reported to a back office system. Nowhere does Infoworld disclose or suggest using a browser as part of an ATM interface through which ATM banking transaction functions are performed.

The Action alleges that Anderson discloses a system for on-line financial services. The Action further alleges that Anderson's system comprises an internet browser interface, specifically a hypertext markup mark-up language Web browser. As previously discussed, Anderson's system works to provide financial information to PC users (Col. 3, line 61). It does not involve an ATM. The Anderson "Conductor system" permits users of personal computers to review or check activity and balances relating to their accounts. Anderson's simple service (Col. 5, lines 48-50) appears limited to enabling a user to merely check or verify their bill payments. Nothing enables a user to actually perform a banking transaction such as dispensing a currency sheet. Anderson's system is used with a customer's personal computer (Col. 1, lines 52-54). Anderson neither teaches nor suggests using a browser or any of the features recited in the claim in connection with in an automated banking machine.

The Action alleges that it would have been obvious (in view of either Infoworld or Anderson) to provide the LA Times ATM with a Web browser interface. The purported reason

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provided in the Action is to enable the ATM user to perform all the typical ATM functions, including transactions over the Web and dispensing currency sheets through the output devices. Appellants respectfully submit that the relied upon reason is derived through hindsight based on Appellants' teachings. None of the applied references teaches, suggests, or provides any motivation for enabling an ATM to perform ATM transactions such as dispensing currency sheets, through use of a browser or over the Web, as the Action alleges. As previously discussed, each specific reference lacks the ability to perform ATM transactions over the Web. The Action admits this deficiency in the LA Times article. Infoworld is limited to transaction monitoring, and is likewise applicable to monitoring cash register transactions. Anderson's system is limited to enabling enumerated simple services such as checking account balances with a customer's PC. None of these references teaches or suggests the alleged ability to perform ATM transactions (including dispensing currency) over the Web or through use of documents processed by a browser. It follows that the cited art also cannot teach or suggest modifying the ATM described in LA Times to make it appear to the user that the ATM machine was local to the computer resource containing the ATM user's brokerage account. Nowhere do LA Times, Infoworld or Anderson disclose or suggest such features. As the Action points to no prior art teaching, suggestion, motivation or knowledge that would cause one to produce a banking machine operating in accordance with the method of claim 8, the rejection is legally improper.

The Action alleges Official notice regarding the "fact" that it is well known (in the art of sheet feeders) that documents which are processed by the controlling Web browser interface of a "particular" sheet feeding machine contain instructions for controlling the output devices of the machine, such as dispense instructions for feeding sheets through the output devices of the

machine. The Action further alleges that such an arrangement provides an effective and reliable control system for the output devices of the machine. Appellants disagree.

Appellants challenge the assertions of "Official notice." Where is the prior art teaching of this alleged "fact"? This Application claims priority back to November 27, 1996. Where is the evidence of record of any prior art teaching of documents (such as HTML documents) containing dispense instructions for feeding sheets through output devices of a machine, especially an automated banking machine? The present evidence of record does not teach or suggest such features. The rejection relies on conclusory statements, not evidence of record. The Action's mere assertions do not constitute the required prior art evidence of record, and thus lack substantial evidence support. The determination of patentability must be based on evidence of record, not on unsubstantiated assertions under the guise of an Official notice (which is the present situation). As the evidence of record does not support the rejection, the claims should be allowed. *In re Zurko*, supra. *In re Lee*, supra. MPEP § 2144.03.

The decision by the Board dated March 9, 2005 with respect to Application No. 09/193,791 (Appeal No. 2004-1824) has addressed the legality of the same Official Notice argument made by the Office with respect to LA Times and Infoworld. In this decision (at page 6, line 13-22) the Board quoted *Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21 which holds that "Assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertions or the notoriety or repute of the cited reference [citations omitted]. Allegations concerning specific 'knowledge' of the prior art, which might be peculiar to a particular art should also be supported

and the appellant similarly given the opportunity to make a challenge." The Board then specifically stated that as the Examiner "has not provided such support for the examiner's argument, that argument is not well taken."

Since the same argument presented by the Office in U.S. Application No. 09/193,791 has been "cut and pasted" into the Action for the present case, Appellants submit that all of the rejections of claims 1-32 in view LA Times, Infoworld and Anderson based on this same Official Notice argument are improper and should be withdrawn. Further, as the identical arguments have previously been considered and decided by the Board, it is respectfully submitted that the Office is barred by principles of *res judicata* and/or collateral estoppel from presenting the same arguments.

In order to establish *prima facie* obviousness it must be shown that <u>all</u> the elements and relationships recited in the claim are <u>known</u> in the prior art. The Action has failed to show where each of the method steps recited in claim 8 are shown in LA Times, Infoworld, or Anderson. For example, where do LA Times, Infoworld, or Anderson disclose or suggest "reading card indicia on a card presented by a customer to an automated banking machine, the card indicia including entity data corresponding to an entity with which the customer has an account"? Where do LA Times, Infoworld, or Anderson disclose or suggest "resolving network address data with the banking machine responsive to the entity data and data stored in a data store"? Further, where do LA Times, Infoworld, or Anderson disclose or suggest "operating a browser in the banking machine responsive to the resolved network address data, to access at least one network address in a network"? Where do LA Times, Infoworld, or Anderson disclose or suggest that "the network address accessed corresponds to an address of a server adapted to deliver documents

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corresponding to the entity with which the customer has the account"? Nowhere do LA Times, Infoworld, or Anderson disclose or suggest, either individually or in combination, these steps recited in claim 8.

As Appellants have shown, the Action does not factually support any *prima facie* conclusion of obviousness. The Appellants are not required to prove patentability. On the contrary, it is the Office which must establish a *prima facie* case of obviousness under the law. Otherwise, in the absence of any other valid rejection (which is the present situation), the Office is legally required to issue a patent.

The Action (on page 9) still further relies on another allegation of "Official notice" asserting that it is "well known" that the documents (containing instructions) in the aforementioned allegation of Official notice are "often" HTML documents/pages. That is, the rejection relies on an unsupported allegation based on other unsupported allegations. Appellants challenge and dispute this further assertion of Official notice. However, as previously discussed, a valid rejection involving Official notice must be based on evidence of record. Where does the evidence of record relate sheet dispensing to an HTML document? Where does the evidence of record relate operation of an automated banking machine sheet dispenser mechanism to an HTML document? It doesn't.

The Action makes the conclusory statement that "the browser of the Citibank ATM, as modified above, would open Web pages related to the user, the Web pages having previously determined addresses and performing different transactional and informational functions as required by the user." However again, the Action has not pointed to any prior art teaching,

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suggestion, or motivation in LA Times, InfoWorld, or Anderson to support such a modification to the Citibank ATM.

Appellants have shown that a *prima facie* case of obviousness has not been established, because the relied upon references do not teach or suggest all of the recited claim features and relationships. The Office has not met the burden of establishing *prima facie* obviousness. It follows that the rejection is not legally valid.

The Action is silent as to how the LA Times teaching could be modified by the teachings of either Infoworld or Anderson. Nor has any evidence been presented that LA Times is structurally and functionally capable of being modified by the teachings of either Infoworld or Anderson, especially to produce the recited invention. For example, the Action has not shown that NCR's alleged ATM technology (Infoworld) is capable of modifying or useable in conjunction with Citibank's ATM technology (LA Times). Nor has the Action shown that Anderson's "Conductor system" architecture is capable of modifying or useable in conjunction with Citibank's ATM technology (LA Times). Nor has the Action presented a valid prior art motivation to combine the features in these references. Since the Action does not explain the rejection with reasonable specificity, it also procedurally fails to establish a *prima facie* case of obviousness. *Ex parte Blanc*, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989). Thus it would not have been obvious to one having ordinary skill in the art to have modified LA Times with the teachings of either Infoworld or Anderson as alleged.

Furthermore, even if it were somehow possible to modify the system of LA Times with the teachings of either Infoworld or Anderson as alleged (which it isn't), such modification still would not have resulted in the recited features and relationships of claim 8. For example, even if

it were somehow possible to modify the system of LA Times (1994) with the teaching of

Infoworld it would have at best resulted in use of the Top End transaction processing monitoring

program in connection with an ATM. However, Infoworld (beginning in July 1996) already

teaches use of Top End in connection with an ATM. Thus modification (if somehow possible) of

LA Times with the teachings of Infoworld would not have produced the recited invention. Thus

it would not have been obvious to one having ordinary skill in the art to have modified LA Times

with the teachings of Infoworld to have produced the recited invention.

Even if it were somehow possible to modify the system of LA Times with the teachings

of Anderson it would have at best resulted in providing Anderson's simple services such as

checking a brokerage account balance with a customer's PC. Thus modification of LA Times

with the teachings of Anderson would not have produced the recited invention. Thus it would

not have been obvious to one having ordinary skill in the art, to have modified LA Times with

the teachings of Anderson to have produced the recited invention.

It follows that not all of the recited features and relationships are taught or suggested by

the applied references. However, to establish *prima facie* obviousness, it must be shown that all

features and relationships recited in the claim are known in the prior art. Thus the Office has not

made a *prima facie* showing of obviousness. Appellants respectfully submit that the deficient

nature of the references, and the lack of supporting evidence of record with regard to the Official

notices, renders the rejection invalid.

The attempts to combine the alleged teachings are clearly attempts at hindsight

reconstruction of Appellants' claimed invention, which is legally impermissible and does not

constitute a valid basis for a finding of obviousness. *In re Fritch*, 22 USPQ2d 1780 (Fed. Cir.

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1992). The rejections, which lack the necessary evidence and rationale, are based on knowledge

gleaned only from Appellants' disclosure.

In conclusion, none of the relied upon references, taken alone or in combination,

discloses or suggests the features and relationships that are specifically recited in claim 8. Based

on all legal tests, a *prima facie* case of obviousness has not been established. Furthermore, it

would not have been obvious to one having ordinary skill in the art to have combined the

references as alleged. The applied prior art is devoid of any such teaching, suggestion, or

motivation for combining features of the references so as to produce the recited invention.

Nevertheless, even if it were somehow possible for the features of the cited references to be

combined as alleged, the resultant combination still would not have resulted in the claimed

invention. Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection should be

reversed.

Claim 9

Claim 9 depends from claim 8. LA Times, Infoworld and Anderson do not disclose or

suggest processing at least one document corresponding to the entity with which the customer

has the account, from the server, and providing at least one output through an output device of an

automated banking machine responsive to the at least one document. Nothing in the cited art

teaches accessing and processing with an ATM a document, such as an HTML document,

associated with an entity with which the customer has an account. Nothing discloses or suggests

processing such a document with a browser to produce an output from the banking machine

corresponding to that entity. Thus the Office has not established *prima facie* obviousness with respect to claim 9.

Claim 10

Claim 10 depends from claim 9. LA Times, Infoworld and Anderson do not disclose or suggest providing at least one visual output through a display of an automated banking machine responsive to a document corresponding to an entity with which the customer has an account Thus the Office has not established *prima facie* obviousness with respect to claim 10.

Claim 11

Claim 11 depends from claim 8. LA Times, Infoworld and Anderson do not disclose or suggest processing the first document with a browser in the automated banking machine and operating the transaction function device responsive to the at least one instruction in the first document. Where do any of the cited references disclose or suggest operating a transaction function device of a banking machine responsive to processing instructions included in documents, such as HTML documents? Thus the Office has not established *prima facie* obviousness with respect to claim 11.

Claim 12

Claim 12 depends from claim 8. LA Times, Infoworld and Anderson do not disclose or suggest providing a plurality of servers, one for each of a plurality of entities with which a plurality of users of the automated banking machine have accounts as recited. In addition, LA

Times, Infoworld and Anderson do not disclose or suggest that each server is in operative connection with a network, has a corresponding network address, and is adapted to deliver at least one document corresponding to the entity with which it is associated. Further, LA Times, Infoworld and Anderson do not disclose or suggest repeating steps (a) through (c) for each card presented by a customer at the automated banking machine. In addition, LA Times, Infoworld and Anderson do not disclose or suggest that each customer card is operative to cause the browser in the automated banking machine to connect to the server including the at least one document corresponding to the entity with which the customer has their account. Thus the Office has not established *prima facie* obviousness with respect to claim 12.

Claim 13

Claim 13 depends from claim 12. LA Times, Infoworld and Anderson do not disclose or suggest that an automated banking machine includes a display in operative connection with a browser as recited. In addition, LA Times, Infoworld and Anderson do not disclose or suggest documents which include instructions for producing at least one screen uniquely associated with the corresponding entity with which the customer has their account. Further, LA Times, Infoworld and Anderson do not disclose or suggest that the browser in the automated banking machine is operative responsive to the instructions in the documents to cause to be produced on the display of the banking machine, the at least one screen uniquely associated with the entity with which the customer has their account. Thus the Office has not established *prima facie* obviousness with respect to claim 13.

Claim 14

Claim 14 depends from claim 8. LA Times, Infoworld and Anderson do not disclose or suggest charging the account of the customer a transaction fee for using the automated banking machine, and sharing at least a portion of the transaction fee between the entity with which the customer has an account and a further entity which operates the automated banking machine. Where do any references disclose or suggest sharing transaction fees between entities? Thus the Office has not established *prima facie* obviousness with respect to claim 14.

Claim 15

Claim 15 depends from claim 8. LA Times, Infoworld and Anderson do not disclose or suggest accessing with a browser, a plurality of documents from a server associated with an entity with which the customer has the account. Further LA Times, Infoworld and Anderson do not disclose or suggest accessing with a browser operating in an automated banking machine, at least one advertising document from a further server operated by an advertising entity. In addition, LA Times, Infoworld and Anderson do not disclose or suggest processing the advertising document with a browser to produce advertising content through an output device in operative connection with the automated banking machine. The references disclose nothing about advertising through an ATM, or any of the other recited features and relationships. Thus the Office has not established *prima facie* obviousness with respect to claim 15.

Claim 16

Claim 16 depends from claim 15. LA Times, Infoworld and Anderson do not disclose or suggest making a payment by an advertising entity to a further entity operating the automated banking machine to compensate the further entity for having the advertising entity present advertising content on the banking machine. The cited references again, disclose or suggest nothing pertinent to the recited features. Thus the Office has not established *prima facie* obviousness with respect to claim 16.

Claim 17

Claim 17 depends from claim 15. LA Times, Infoworld and Anderson do not disclose or suggest executing a step of accessing with a browser operating in the automated banking machine at least one advertising document from a further server operated by an advertising entity during a step of accessing with a browser a plurality of documents from the server associated with the entity with which the customer has the account as recited. Thus the Office has not established *prima facie* obviousness with respect to claim 17.

Claim 18

Claim 18 depends from claim 15. LA Times, Infoworld and Anderson do not disclose or suggest accessing at least one document with a first browser operating in an automated banking machine, and accessing at least one document with a second browser operating in the automated banking machine. The cited references teach nothing about operating even one browser in an

automated banking machine, let alone two browsers. Thus the Office has not established *prima facie* obviousness with respect to claim 18.

Claim 19

Claim 19 is an independent claim directed to an apparatus. As discussed previously with respect to claim 1, the banking functions the Action alleges the ATM of LA Times is "considered to perform" and the components that the ATM is "considered to possess" are pure speculation by the Office. LA Times is silent as to the available banking functions and components included with the ATM. For example, where does LA Times specifically teach that the ATM is able to provide account access, transfer funds, and dispense statements, especially in 1994?

Appellants respectfully disagree that the ATM components the Action atttributes to LA Times, such as a card reader, are inherent in LA Times. Anticipation by inherency requires that the Office establish that persons skilled in the art would recognize that the missing components are "necessarily present" in the LA Times reference. To establish inherency the Office must prove through citation to prior art that the features alleged to be inherent are "necessarily present" in LA Times. However, there is no teaching or suggestion in LA Times that the described Citibank "specially designed automated teller machines" include a card reader or are able to provide account access, transfer funds, and dispense statements. Nor has the Office proved the assertions in the Action that every ATM includes a card reader, and is able to provide account access, transfer funds, and dispense statements. That is, the Office has not proved through citation to prior art that the alleged features are "necessarily present" in LA Times. Indeed, the "specially designed" machines of LA Times may operate in response to the manual input of

brokerage account numbers or in response to other manual inputs and may not involve a card reader. Inherency may not be established based on probabilities or possibilities (which is the present situation). It is plainly improper to reject a claim based merely on the (speculative) possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999).

Nor has the Action established in the prior art what constitutes the alleged "normal components" or "a typical ATM." Nor is there any teaching or suggestion that an ATM in LA Times is "a typical ATM", as alleged. Contrarily, LA Times specifically teaches that the ATM is "specially designed" (i.e., atypical). The limited locations (and thus quantity) of the ATMs also points to their uniqueness. Thus, in light of Appellants' contrary showing, the assertion that LA Times has "a typical ATM" with "normal components" is not legally appropriate.

The Action's assertions are not based on any evidence in the record. An assertion of prior art knowledge not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, supra. The determination of patentability must be based on evidence of record. *In re Lee*, supra. Appellants respectfully submit that because the rejection is based on mere assertions and not proper evidence of record, it is not a valid rejection.

As discussed previously with respect to claims 1 and 8, the Action (at page 8, lines 3-4) admits that LA Times does not teach or suggest the user interface at the ATM being a Web browser based interface. That is, the Action admits that LA Times does not teach or suggest an ATM having a browser as recited in claim 19. The Appellants respectfully submit that LA Times also does not teach or suggest an ATM that is able to receive HTML format documents. Contrarily, the limited geographical locations of the ATMs in LA Times appear to point to the

system as being locally based with conventional prior art communications and programming rather than Web-based or otherwise using a browser within the ATM. Nor is there any teaching or suggestion in LA Times that an ATM needs or could operate with a browser. Furthermore, even if it were somehow possible for the ATM in LA Times to receive documents from a server using a browser operating in the ATM (which it isn't), there would still be no teaching or suggestion to have a browser in an automated banking machine operate responsive to reading indicia on a card, to access at least one network address in a network corresponding to the card indicia, and wherein the network address accessed corresponds to an address of a server adapted to deliver documents associated with a particular financial institution. Nothing in the cited art discloses or suggests the recited features.

The Action alleges that in Infoworld a "browser interface is the interface through which all the ATM banking functions of the NCR ATM machine are performed, such as account access, funds transfer, the dispensing of currency and receipts responsive to the interaction of the user with the Web browser interface." The Appellants respectfully disagree.

Infoworld does not teach or suggest such features. For example, where does Infoworld teach or suggest that ATM banking functions are performed through a browser interface? Where does Infoworld teach or suggest that the discussed Top End software carries out and controls the ATM transactions? Rather, Infoworld discusses a TP <u>monitoring</u> program that <u>monitors</u> or tracks transactions. Apparently, Top End (similar to present day TP monitors) ensures that each monitored transaction gets completed or is completely rolled back. Top End provides a Web browser interface on a remote back end transaction processing system away from any cash register or ATM. In Infoworld, client software (not involving a browser) runs on cash registers

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and ATMs. This client software transmits transaction data to a remote "back end" system which includes a Web browser. Infoworld does not teach or suggest (nor have any use for) a Web browser operating on an ATM. This point was considered by the Board in Appeal No. 2004-1824, in which the Board agreed with Appellants on the teachings of Infoworld.

Appellants respectfully submit that the Action takes the Infoworld language out of context. Infoworld does not state that it enables ATM transactions over the Web to make one or 10,000 machines look as if they are local to a computing resource, as alleged in the Action. Contrarily, Infoworld teaches that the "one or 10,000 machines" comment is directed to the Top End program reporting transactions to a back-end accounting system. Infoworld admits that NCR is still "trying to overcome" limitations "to enable" transactions over the Web. Thus Infoworld specifically indicates that it is not capable of carrying out ATM transactions over the Web.

Furthermore, the system described in Infoworld describes credit card transactions being controlled and performed through a conventional proprietary transaction network with the account balancing transfers being monitored and reported to a back office system. Nowhere does Infoworld disclose or suggest using a browser as part of an ATM interface through which an ATM carries out banking transaction functions.

The Action alleges that Anderson discloses a system for on-line financial services. The Action further alleges that Anderson's system comprises an Internet browser interface, specifically a hypertext markup language Web browser. As previously discussed, Anderson's system works to provide financial information to PC users. (Col. 3, line 61). Anderson does not teach or suggest an ATM. The Anderson "Conductor system" permits users of personal

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computers to review or check activity and balances relating to their accounts. Anderson's simple

service (Col. 5, lines 48-50) appears limited to enabling a user to merely check or verify their bill

payments. Nothing enables a user to actually perform a banking transaction such as dispensing a

currency sheet. Anderson's system is used with a customer's personal computer (Col. 1, lines 52-

54). Nothing in Anderson teaches or suggests an automated banking machine system as recited

in claim 19.

The Action alleges that it would have been obvious (in view of either Infoworld or

Anderson) to provide the LA Times ATM with a Web browser interface. The reason provided in

the Action is to enable the ATM user to perform all the typical ATM functions, including

transactions over the Web and dispensing currency sheets through the output devices. Appellants

respectfully submit that this assertion is without merit.

None of the applied references teaches, suggests, or provides motivation for enabling an

ATM to perform ATM transactions through operation of a browser, including transactions

dispensing currency sheets, as alleged in the Action. As previously discussed, each specific

reference lacks the ability to perform the ATM transactions in the manner specifically recited in

claim 19. The Action admits this deficiency in the LA Times article. Infoworld is limited in its

disclosure to transaction monitoring. Anderson's system is limited to enabling simple services

such as checking account balances with a customer's PC. None of these references teaches or

suggests the alleged ability to perform ATM transactions (including dispensing currency) over

the Web or through use of a browser. It follows that the references combined also cannot teach

or suggest modifying the ATM described in LA Times to make it appear to the user that the

ATM machine is local to the computer resource containing the relevant bank or brokerage

account. Nowhere do LA Times, Infoworld or Anderson disclose or suggest such features.

Further, the Action points to no prior art teaching, suggestion or motivation that would cause one skilled in the art to produce a system with features as specifically recited in claim 19.

The Action alleges Official notice regarding the "fact" that it is well known (in the art of sheet feeders) that documents which are processed by the controlling Web browser interface of a "particular" sheet feeding machine contain instructions for controlling the output devices of the machine, such as dispense instructions for feeding sheets through the output devices of the machine. The Action further alleges that such an arrangement provides an effective and reliable control system for the output devices of the machine. Appellants disagree.

Appellants challenge the assertions of "Official notice." Where is the prior art teaching of this alleged "fact"? This Application claims priority back to November 27, 1996. Where is the evidence of record of any prior art teaching of documents (such as HTML documents) containing dispense instructions for feeding sheets through output devices of a machine, especially an automated banking machine? The present evidence of record does not teach or suggest such features. The rejection relies on conclusory statements, not evidence of record. The Action's mere assertions do not constitute the required prior art evidence of record, and thus lack substantial evidence support. The determination of patentability must be based on evidence of record, not on unsubstantiated assertions under the guise of an Official notice (which is the present situation). As the evidence of record does not support the rejection, the claims should be allowed. *In re Zurko*, supra. *In re Lee*, supra. MPEP § 2144.03.

Furthermore, as discussed previously with respect to claim 8, the decision dated March 9, 2005 by the Board in Appeal No. 2004-1824 with respect to Application No. 09/193,791 has

addressed the legality of the same Official notice argument made by the Office with respect to

LA Times and Infoworld. In this decision (at page 6, line 13-22) the Board quoted *Ahlert*, 424

F.2d at 1091, 165 USPQ at 420-21 which holds that "Assertions of technical facts in areas of

esoteric technology must always be supported by citation to some reference work recognized as

standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to

challenge the correctness of the assertions or the notoriety or repute of the cited reference

[citations omitted]. Allegations concerning specific 'knowledge' of the prior art, which might be

peculiar to a particular art should also be supported and the appellant similarly given the

opportunity to make a challenge." The Board then specifically stated that the Examiner "has not

provided such support for the examiner's argument, that argument is not well taken."

Since the same argument presented by the Office in U.S. Application No. 09/193,791 has

been "cut and pasted" into the Action for the present case, Appellants submit that all of the

rejections of claims 1-32 in view of LA Times, Infoworld and Anderson based on this same

Official notice argument are improper and should be withdrawn. Further, as the identical

arguments have previously been considered and decided by the Board, it is respectfully submitted

that the Office is barred by principles of *res judicata* and/or collateral estoppel from presenting

the same arguments again.

In order to establish *prima facie* obviousness it must be shown that all the elements and

relationships recited in the claim are known in the prior art. The Action has failed to show where

each of the elements, features and relationships recited in claim 19 are shown in LA Times,

Infoworld, or Anderson. For example, where do LA Times, Infoworld, or Anderson disclose or

suggest that "wherein the banking machine includes a computer having a browser operating

therein"? Where do LA Times, Infoworld, or Anderson disclose or suggest a card reader? Where do LA Times, Infoworld, or Anderson disclose or suggest that an "automated banking machine is operative responsive to reading card indicia on a card read by the card reading device, to cause the browser to connect through the network to a network address of an institution server corresponding to the card indicia"? Nowhere do LA Times, Infoworld, or Anderson disclose or suggest, either individually or in combination, these elements, features and relationships recited in claim 19.

As Appellants have shown, the Action does not factually support any *prima facie* conclusion of obviousness. The Appellants are not required to prove patentability. On the contrary, it is the Office which must establish a *prima facie* case of obviousness under the law. Otherwise, in the absence of any other valid rejection (which is the present situation), the Office is legally required to issue a patent.

The Action (on page 9) still further relies on another allegation of "Official notice" asserting that it is "well known" that the documents (containing instructions) in the aforementioned allegation of Official notice are "often" HTML documents/pages. That is, the rejection relies on an unsupported Official notice allegation based on other unsupported Official notice allegations. Appellants challenge and dispute this further assertion of Official notice. However, as previously discussed, a valid rejection involving Official notice must be based on evidence of record. Where does the evidence of record relate card indicia read from a card to an address of an HTML document? Where does the evidence of record relate operation of an automated banking machine to access an address of an HTML document associated with a particular financial institution, as recited in claim 19? It does not.

The Action makes the conclusory statement that, "the browser of the Citibank ATM, as modified above, would open Web pages related to the user, the Web pages having previously determined addresses and performing different transactional and informational functions as required by the user." However again, the Action has not pointed to any prior art teaching, suggestions, or motivation in LA Times, InfoWorld, or Anderson to support such a modification to the LA Times ATM.

Appellants have shown that a *prima facie* case of obviousness has not been established because the relied upon references do not teach or suggest all of the recited claim features and relationships of claim 19. The Office has not met the burden of establishing *prima facie* obviousness. It follows that the rejection is not legally valid.

The Action is silent as to how the LA Times teaching could be modified by the teachings of either Infoworld or Anderson. Nor has any evidence been presented that LA Times is structurally and functionally capable of being modified as set forth by the teaching of either Infoworld or Anderson, especially to produce the recited invention. For example, the Action has not shown that NCR's alleged ATM technology (Infoworld) may be combined or used with Citibank's ATM technology (LA Times). Nor has the Action shown that Anderson's "Conductor system" architecture may be combined or used with Citibank's ATM technology (LA Times). Nor has the Action presented a valid prior art suggestion or motivation to combine the references. Since the Action does not explain the rejection with reasonable specificity, it also procedurally fails to establish a *prima facie* case of obviousness. *Ex parte Blanc*, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989). Thus it would not have been obvious to one having ordinary

skill in the art to have modified LA Times with the teachings of either Infoworld or Anderson as alleged.

Furthermore, even if it were somehow possible to modify the system of LA Times with the teachings of either Infoworld or Anderson as alleged (which it isn't), such modification still would not have resulted in the recited features and relationships of claim 19. For example, even if it were somehow possible to modify the system of LA Times (1994) with the teaching of Infoworld, it would have at best resulted in use of the Top End monitoring program with regard to an ATM. However, Infoworld (beginning in July 1996) already teaches use of Top End with regard to an ATM. Thus modification (if somehow possible) of LA Times with the teachings of Infoworld would not have produced the recited invention. Thus it would not have been obvious to one having ordinary skill in the art to have modified LA Times with the teachings of Infoworld to have produced the recited invention.

Also, for example, even if it were somehow possible to modify the system of LA Times with the teachings of Anderson, it would have at best resulted in providing simple services such as checking a brokerage account balance with a customer's PC. Thus modification of LA Times with the teachings of Anderson would not have produced the recited invention. Thus it would not have been obvious to one having ordinary skill in the art, to have modified LA Times with the teachings of Anderson to have produced the recited invention.

It follows that not all of the recited features and relationships are taught or suggested by the applied references. However, to establish *prima facie* obviousness, it must be shown that all features and relationships recited in the claim are known in the prior art. Thus the Office has not made a *prima facie* showing of obviousness. Appellants respectfully submit that the deficient

nature of the references, and the lack of supporting evidence of record with regard to the Official notices, renders the rejection invalid.

The attempts to combine the alleged teachings are clearly attempts at hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 22 USPQ2d 1780 (Fed. Cir. 1992). The rejections, which lack the necessary evidence and rationale, are based on knowledge gleaned only from Appellants' disclosure.

None of the relied upon references, taken alone or in combination, discloses or suggests the features and relationships that are specifically recited in claim 19. Thus a *prima facie* case of obviousness has not been established. Furthermore, it would not have been obvious to one having ordinary skill in the art to have combined the references as alleged. The applied prior art is devoid of any such teaching, suggestion, or motivation for combining features of the references so as to produce the recited invention. Nevertheless, even if it were somehow possible for the references to be combined as alleged, the resultant combination still would not have resulted in the claimed invention. Therefore, Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection should be reversed.

Claim 20

Claim 20 depends from claim 19. LA Times, Infoworld and Anderson do not disclose or suggest a browser operative to process at least one document from an institution server and to provide an output responsive to the document through an output device on an automated banking machine. Thus the Office has not established *prima facie* obviousness with respect to claim 20.

Claim 21

Claim 21 depends from claim 19. LA Times, Infoworld and Anderson do not disclose or suggest a browser in an automated banking machine that is operative to process at least one document from an institution server as recited. In addition, LA Times, Infoworld and Anderson do not disclose or suggest that the document processed by the browser in the automated banking machine, includes at least one instruction for enabling operation of a transaction function device included in the automated banking machine. Further, LA Times, Infoworld and Anderson do not disclose or suggest that the transaction function device is enabled to operate responsive to the browser processing the document. Thus the Office has not established *prima facie* obviousness with respect to claim 21.

Claim 22

Claim 22 depends from claim 21. LA Times, Infoworld and Anderson do not disclose or suggest a document processed by a browser in an automated banking machine which includes at least one sheet dispenser instruction. In addition, LA Times, Infoworld and Anderson do not disclose or suggest an automated banking machine with a sheet dispenser. Further, LA Times, Infoworld and Anderson do not disclose or suggest an automated banking machine which is enabled to dispense at least one sheet responsive to the browser processing the document. Thus the Office has not established *prima facie* obviousness with respect to claim 22.

Claim 23

Claim 23 depends from claim 19. LA Times, Infoworld and Anderson do not disclose or suggest an automated banking machine which is operative to resolve a network address

responsive to a BIN number included in card indicia read from a card. Thus the Office has not established *prima facie* obviousness with respect to claim 23.

Claim 24

Claim 24 depends from claim 19. LA Times, Infoworld and Anderson do not disclose or suggest a computer in an automated banking machine which is programmed to operate to cause a browser to access an advertising document from an advertising server. In addition, LA Times, Infoworld and Anderson do not disclose or suggest that the computer of the automated banking machine is operative to output advertising content through the output device of the automated banking machine responsive to the advertising document. Thus the Office has not established *prima facie* obviousness with respect to claim 24.

Claim 25

Claim 25 depends from claim 24. LA Times, Infoworld and Anderson do not disclose or suggest a computer in an automated banking machine which is operative to cause a browser to process at least one document from an institution server, which document includes device instructions. In addition, LA Times, Infoworld and Anderson do not disclose or suggest that a computer in the automated banking machine is adapted to enable a transaction function device of the automated banking machine to operate responsive to the device instructions. Further, LA Times, Infoworld and Anderson do not disclose or suggest a computer in an automated banking machine which operates to cause advertising content to be output through an output device during operation of the transaction function device. Thus the Office has not established *prima facie* obviousness with respect to claim 25.

Claim 26

Claim 26 depends from claim 25. LA Times, Infoworld and Anderson do not disclose or suggest an automated banking machine with a note dispenser. In addition, LA Times, Infoworld and Anderson do not disclose or suggest a computer in an automated banking machine which is adapted to enable a note dispenser of the automated banking machine to operate responsive to the device instructions. Further, LA Times, Infoworld and Anderson do not disclose or suggest a computer in an automated banking machine which operates to cause advertising content to be output through an output device during operation of the note dispenser. Thus the Office has not established *prima facie* obviousness with respect to claim 26.

Claim 27

Claim 27 depends from claim 24. LA Times, Infoworld and Anderson do not disclose or suggest a computer in an automated banking machine which includes a first browser and a second browser operating therein. Further, LA Times, Infoworld and Anderson do not disclose or suggest that the computer in the automated banking machine operates the first browser to access an institution server and the second browser to access an advertising server. Thus the Office has not established *prima facie* obviousness with respect to claim 27.

Claim 28

Claim 28 depends from claim 1. LA Times, Infoworld and Anderson do not disclose or suggest an automated banking machine which includes a cash dispenser. Thus the Office has not established *prima facie* obviousness with respect to claim 28.

Claim 29

Claim 29 depends from claim 28. LA Times, Infoworld and Anderson do not disclose or suggest dispensing cash through operation of a cash dispenser. Thus the Office has not established *prima facie* obviousness with respect to claim 29.

Claim 30

Claim 30 depends from claim 8. LA Times, Infoworld and Anderson do not disclose or suggest an automated banking machine which includes a cash dispenser. Thus the Office has not established *prima facie* obviousness with respect to claim 30.

Claim 31

Claim 31 depends from claim 30. LA Times, Infoworld and Anderson do not disclose or suggest dispensing cash through operation of a cash dispenser. Thus the Office has not established *prima facie* obviousness with respect to claim 31.

Claim 32

Claim 32 depends from claim 19. LA Times, Infoworld and Anderson do not disclose or suggest an automated banking machine which comprises a cash dispenser. Thus the Office has not established *prima facie* obviousness with respect to claim 32.

CONCLUSION

Each of Appellants' pending claims specifically recites elements, features, relationships, and steps that are neither disclosed nor suggested in any of the applied prior art. Furthermore, the applied prior art is devoid of any teaching, suggestion, or motivation for producing the recited invention. For these reasons, it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,
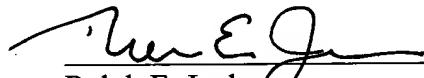
Ralph E. Jocke   Reg. No. 31,029
WALKER & JOCKE
231 South Broadway
Medina, Ohio 44256
(330) 721-0000

CLAIMS APPENDIX

1.   A method comprising the steps of:

      a)   determining through operation of an automated banking machine, data

corresponding to an entity with which a customer operating the machine

has an account;

      b)   providing through an output device on the automated banking machine at

least one output uniquely corresponding to the entity with which the

customer has the account.

2.   The method according to claim 1 wherein step (a) includes reading indicia with a
reading device in operative connection with the banking machine.

3.   The method according to claim 2 wherein step (a) includes reading indicia on a
card with a card reader in connection with the automated banking machine.

4.   The method according to claim 1 wherein step (b) includes providing at least one
visual output corresponding to the entity through the output device.

5. The method according to claim 4 wherein step (b) includes processing at least one document through a browser operating in a computer in operative connection with an automated banking machine.

6. The method according to claim 5 wherein in step (b) the at least one document is determined responsive to the data determined in step (a).

7. The method according to claim 6 and prior to step (b) further comprising the step of:

accessing the at least one document at a system address, wherein the system address is determined responsive to the data determined in step (a).

8. A method comprising the steps of:

a) reading card indicia on a card presented by a customer to an automated banking machine, the card indicia including entity data corresponding to an entity with which the customer has an account;

b) resolving network address data with the banking machine responsive to the entity data and data stored in a data store;

c)   operating a browser in the banking machine responsive to the resolved

network address data, to access at least one network address in a network,

wherein the network address accessed corresponds to an address of a

server adapted to deliver documents corresponding to the entity with

which the customer has the account.

9.   The method according to claim 8 wherein the banking machine includes an output

device, and further comprising the steps of processing at least one document corresponding to the

entity with which the customer has the account from the server, and providing at least one output

through the output device responsive to the at least one document.

10.   The method according to claim 9 wherein the output device comprises a display,

and wherein in the providing step the output includes a visual output.

11.   The method according to claim 8 wherein the automated banking machine

includes at least one transaction function device, and wherein at least a first one of the documents

includes at least one instruction which is operative to cause operation of the transaction function

device, and further comprising the step of processing the first document with the browser and

operating the transaction function device responsive to the at least one instruction in the first

document.

12.   The method according to claim 8 and further comprising the steps of:

d) providing a plurality of servers, one for each of a plurality of entities with which a plurality of users of the automated banking machine have accounts, each server being in operative connection with a network and having a corresponding network address, each server being adapted to deliver at least one document corresponding to the entity with which it is associated;

repeating steps (a) through (c) for each card presented by a customer at the automated banking machine, whereby each customer card is operative to cause the browser to connect to the server including the at least one document corresponding to the entity with which the customer has their account.

13. The method according to claim 12 wherein the automated banking machine includes a display in operative connection with the browser, and wherein the documents include instructions for producing at least one screen uniquely associated with the corresponding entity, and wherein in step (c) the browser is operative responsive to the instructions in the documents to cause to be produced on the display the at least one screen uniquely associated with the entity with which the customer has their account.

14. The method according to claim 8 wherein the automated banking machine is operated by a further entity, and further comprising the steps of:

d) charging the account of the customer a transaction fee for use of the automated banking machine operated by the further entity;

e) sharing between the entity and the further entity at least a portion of the transaction fee.

15. The method according to claim 8 and further comprising the step of:

d) accessing with a browser a plurality of documents from the server associated with the entity with which the customer has the account;

e) accessing with a browser operating in the automated banking machine at least one advertising document from a further server operated by an advertising entity;

f) processing the advertising document with a browser to produce advertising content through an output device in operative connection with the automated banking machine.

16. The method according to claim 15 wherein the automated banking machine is operated by a further entity, and further comprising the step of:

g) making a payment by the advertising entity to the further entity, whereby the further entity operating the automated banking machine is compensated for having the advertising entity present advertising content on the banking machine.

17. The method according to claim 15 wherein step (e) is executed during step (d).

18. The method according to claim 15 wherein in step (d) at least one document is accessed with a first browser operating in the banking machine, and wherein in step (e) at least one document is accessed with a second browser operating in the banking machine.

19. An apparatus comprising:

a plurality of institution servers, each institution server associated with one of a plurality of financial institutions, wherein each institution server has at least one unique network address, and wherein each institution server is operative to deliver at least one document associated with the respective institution;

a network in operative connection with each of the plurality of institution servers;

at least one automated banking machine, wherein the banking machine includes a

computer having a browser operating therein, a card reader and an output device

in operative connection with the computer;

wherein the automated banking machine is operative responsive to reading card

indicia on a card read by the card reading device, to cause the browser to connect

through the network to a network address of an institution server corresponding to

the card indicia.

20.   The apparatus according to claim 19 wherein the browser is operative to process

at least one document from the institution server and to provide an output responsive to the

document through the output device on the banking machine.

21.   The apparatus according to claim 19 wherein the browser is operative to process

at least one document from the institution server, wherein the banking machine includes at least

one transaction function device, and wherein the document includes at least one instruction for

enabling operation of the transaction function device, and wherein the transaction function device

is enabled to operate responsive to the browser processing the document.

22.   The apparatus according to claim 21 wherein the transaction function device

includes a sheet dispenser, and wherein the document includes at least one sheet dispenser

instruction, and wherein the sheet dispenser is enabled to dispense at least one sheet responsive to the browser processing the document.

23. The apparatus according to claim 19 wherein the card indicia includes a BIN number, and wherein the automated banking machine is operative to resolve the network address responsive to the BIN number.

24. The apparatus according to claim 19 and further comprising at least one advertising server in operative connection with the network, wherein the advertising server has at least one unique network address, and wherein the advertising server is operative to provide at least one advertising document, and wherein the computer is programmed to operate to cause the browser to access the advertising document from the advertising server, wherein the computer is operative to output advertising content through the output device responsive to the advertising document.

25. The apparatus according to claim 24 wherein the automated banking machine includes at least one transaction function device in operative connection with the computer, and wherein the computer is operative to cause the browser to process at least one document from the institution server, and wherein the document from the institution server includes device instructions, and wherein the computer is adapted to enable the transaction function device to operate responsive to the device instructions, and wherein the computer operates to cause the

advertising content to be output through the output device during operation of the transaction function device.

26.   The apparatus according to claim 25 wherein the transaction function device includes a note dispenser, and wherein the advertising content is output during operation of the note dispenser.

27.   The apparatus according to claim 24 wherein the computer includes a first browser and a second browser operating therein, and wherein the computer operates the first browser to access the institution server and the second browser to access the advertising server.

28.   The method according to claim 1, wherein in (a) the automated banking machine includes a cash dispenser.

29.   The method according to claim 28, further comprising:

d)   dispensing cash through operation of the cash dispenser.

30.   The method according to claim 8, wherein in (a) the automated banking machine includes a cash dispenser.

31. The method according to claim 30, further comprising:

    d)   dispensing cash through operation of the cash dispenser.

32. The apparatus according to claim 19, wherein the automated banking machine comprises a cash dispenser.

(ix)   **EVIDENCE APPENDIX**

(None)

(x)   **RELATED PROCEEDINGS APPENDIX**

Copy of the Decision of the Board of Patent Appeals and Interferences dated March 9, 2005 with respect to Appeal No. 2004-1824 and Application No. 09/193,791.

Copy of the Decision of the Board of Patent Appeals and Interferences dated October 8, 2003 with respect to Appeal No. 2003-1651 and Application No. 09/193,787.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

MAILED

OCT 0 8 2003

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAY PAUL DRUMMOND et al.

Appeal No. 2003-1651
Application No. 09/193,787[1]

MAILED

OCT 0 8 2003

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

ON BRIEF

Before ABRAMS, McQUADE, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection (Paper No. 18, mailed

September 16, 2002) of claims 1 to 30, which are all of the claims pending in this

application. On page 2 of the reply brief (Paper No. 22, filed April 18, 2003), the

appellants noted that (1) they are willing to amend dependent claim 27 to include

mutually agreeable language in order to overcome the sole rejection of claim 27 as

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[1] Filed November 17, 1998. According to the appellants, the application claims benefit of
provisional Application No. 60/031,956, filed November 27, 1996.

being indefinite under the second paragraph of 35 U.S.C. § 112; and (2) the rejection of

claim 27 no longer appears to be an issue. Accordingly, we deem the appeal with

respect to claim 27 to be withdrawn and we dismiss the appeal with respect to claim 27.

Claims 1 to 26 and 28 to 30 remain on appeal.

We REVERSE.

BACKGROUND

The appellants' invention relates to automated banking machines (specification,

p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants'

brief.

The references of record relied upon by the examiner in rejecting the appealed

claims are:

McLean	4,337,864	July 6, 1982
McMillan	5,436,435	July 25, 1995
Russell et al. (Russell)	5,905,248	May 18, 1999
Zeanah et al. (Zeanah)	5,933,816[2]	Aug. 3, 1999

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[2] This patent issued from Application No. 08/908,413, filed August 7, 1997. This patent claims benefit of provisional Application No. 60/029,209, filed October 31, 1996.

Claims 1 to 6, 8-13, 16 and 22 to 26 stand rejected under 35 U.S.C. § 102(e) as

being anticipated by Zeanah.

Claims 7, 14, 28 and 30 stand rejected under 35 U.S.C. § 103 as being

unpatentable over Zeanah in view of Russell.

Claim 29 stands rejected under 35 U.S.C. § 103 as being unpatentable over

Zeanah in view of Russell and McLean.

Claims 15 and 17 stand rejected under 35 U.S.C. § 103 as being unpatentable

over Zeanah in view of McLean.

Claims 18 to 21 stand rejected under 35 U.S.C. § 103 as being unpatentable

over Zeanah in view of McMillan.

Rather than reiterate the conflicting viewpoints advanced by the examiner and

the appellants regarding the above-noted rejections, we make reference to the answer

(Paper No. 21, mailed March 11, 2003) for the examiner's complete reasoning in

support of the rejections, and to the brief (Paper No. 20, filed January 17, 2003) and

reply brief (Paper No. 22, filed April 18, 2003) for the appellants' arguments thereagainst.

OPINION

The appellants assert (brief, pp. 11-24) that (1) Zeanah is not available as prior art under 35 U.S.C. § 102(e); and (2) the 37 CFR § 1.131 declaration of Jay Paul Drummond (Paper No. 13, filed February 4, 2002) is sufficient to overcome the prior art rejections under appeal. We agree.

The burden of establishing a prima facie case of anticipation resides with the examiner. See In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Likewise, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

It is the examiner's burden to establish that Zeanah is available as prior art under 35 U.S.C. § 102(e)[3] with respect to the claims under appeal. This the examiner has not done.

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[3] 35 U.S.C. § 102(e) provides that a person shall be entitled to a patent unless the invention was described in a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent.

To establish that Zeanah is available as prior art under 35 U.S.C. § 102(e) with respect to the claims under appeal, the examiner must determine that the effective filing date of Zeanah is prior to the effective filing date of the claimed subject matter. Thus, the examiner must determine the effective filing date of Zeanah and the effective filing date of the claimed subject matter.

Zeanah is clearly entitled to at least an effective filing date of August 7, 1997. Zeanah is not entitled to an effective filing date of October 31, 1996 unless the provisional application (Application No. 60/029,209) discloses the claimed invention in the manner required by the first paragraph of 35 U.S.C. § 112.[4] The examiner has not determined that provisional Application No. 60/029,209 discloses the claimed invention in the manner required by the first paragraph of 35 U.S.C. § 112. Accordingly, for purposes of this appeal, the examiner has only determined that Zeanah is entitled to an effective filing date of August 7, 1997.[5]

The appellants claim benefit back to provisional Application No. 60/031,956, filed November 27, 1996. To apply Zeanah as prior art under 35 U.S.C. § 102(e), the

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[4] See 35 U.S.C. § 119(e).

[5] The examiner's position (answer, pp. 14-15) that due to the presumption of validity the patent to Zeanah is presumed to be entitled to the October 31, 1996 filing date of the provisional application is without merit.

examiner must also determine the effective filing date of the claimed subject matter

(e.g., is the claimed subject matter entitled to an effective filing date of November 27,

1996). The examiner has not set forth the effective filing date of the claimed subject

matter.[6]

Since the examiner has not established that the effective filing date of Zeanah is

prior to the effective filing date of the claimed subject matter, the examiner has not

established that Zeanah is available as prior art under 35 U.S.C. § 102(e).

In any event, even if Zeanah was available as prior art under 35 U.S.C. § 102(e)

with an effective filing date of October 31, 1996, the appellants submit that the

Drummond declaration establishes reduction to practice of the subject matter of claims

1-4, 6-19 and 22-27 prior to July 7, 1996, thus overcoming the prior art rejections of

claims 1-4, 6-19 and 22-27. The appellants admit (brief, p. 15) that the differences

between claims 5, 20, 21 and 28 to 30 and claims 1-4, 6-19 and 22-27 would have

been obvious to one of ordinary skill in the art. Thus, the appellants argue that the prior

art rejections of claims 5, 20, 21 and 28 to 30 is also overcomed by the Drummond

declaration.

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[6] The appellants assert that the effective filing date of the claimed subject matter is November 27,
1996.

The examiner's sole expressed objection to accepting the Drummond declaration (answer, pp. 17-18) is that it is not signed by all the joint inventors of the claims under rejection (i.e., claims 1 to 26 and 28 to 30). However, this objection is not a proper basis for refusing to accept the Drummond declaration since that declaration is signed by the inventor of the subject matter of claims 1 to 4, 6 to 19 and 22 to 27). 37 CFR § 1.131 permits such a declaration to be signed by less that all of the inventors.

Since the examiner has not proffered any valid objection as to why the Drummond declaration does not establish a reduction to practice of the subject matter of claims 1-4, 6-19 and 22-27 prior to July 7, 1996, the Drummond declaration must be accepted by us as sufficient to overcome the prior art rejections under appeal.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 6, 8-13, 16 and 22 to 26 under 35 U.S.C. § 102(e) is reversed and the decision of the examiner to reject claims 7, 14, 15, 17 to 21 and 28 to 30 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 6, 8-13, 16 and

22 to 26 under 35 U.S.C. § 102(e) is reversed and the decision of the examiner to reject

claims 7, 14, 15, 17 to 21 and 28 to 30 under 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS
Administrative Patent Judge
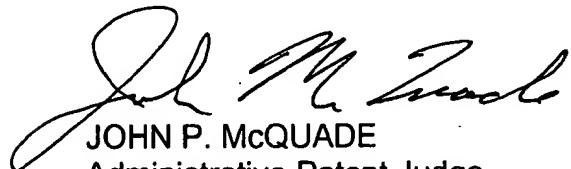
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JOHN P. McQUADE   ) BOARD OF PATENT
Administrative Patent Judge   )   APPEALS
)   AND
) INTERFERENCES
)
)
)
JEFFREY V. NASE   )
Administrative Patent Judge   )

RALPH E. JOCKE
231 SOUTH BROADWAY
MEDINA, OH 44256

JVN/jg

ROUTING FOR DECISIONS OF BOARD OF APPEAL

	Initials	Date
QAS	MB	10/15/03
Director		10/16/03
SPE		
Examiner		
Disposal Recorded by LIE		

Date of Decision	Serial Number	Examiner	Art Unit	Affirmed	Reversed
10/08/03	09/93787	Worjloh	3621	[ ] 101	[ ] 101
				[ ] 102	[✓] 102
				[ ] 103	[✓] 103
				[ ] 112	[ ] 112
				[ ] other	[ ] other

****DUE DATE: **Nov. 18, 2003**

Comments:

37CFR 1.131 overcomes the 102(e) rej ~103.

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte JAY PAUL DRUMMOND, DALE BLACKSON,
BOB A. CICHON, JOSEPH C. ESS, MARK A. MOALES,
DAVID W. WEIS, MARK D. SMITH,
and JAMES CHURCH

Appeal No. 2004-1824
Application No. 09/193,791

ON BRIEF
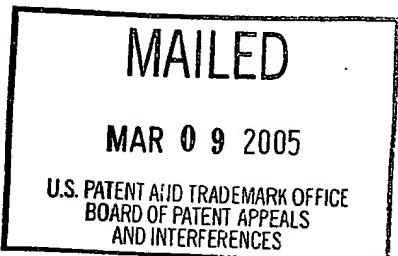
Before OWENS, MACDONALD, and NAPPI, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from a nonfinal rejection of claims 1-20, which are all of the claims in the application.[1]

THE INVENTION

The appellants claim an apparatus comprising an automated transaction machine, and a method for operating the apparatus.

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[1] In an appeal in which claims have been at least twice rejected, the board has jurisdiction as discussed in *Ex parte Lemoine*, 46 USPQ2d 1432 (Bd. Pat. App. & Int. 1995).

1

Claim 1, which claims the apparatus, is illustrative:

1. Apparatus comprising:
    an automated transaction machine including:
    an output device;
    a currency sheet dispenser;
    a computer in operative connection with the output
    device and the currency sheet dispenser; and
    software executable in the computer, wherein the
    software includes a browser, and wherein during
    operation of the currency sheet dispenser the
    software is operative to provide an output through
    the output device responsive to a document
    accessed by the browser.

THE REFERENCES

Dialog® File 630: Times Staff and Wire Reports, "Trade-It-Yourself Bank Machines Make a Debut - Securities: Citibank is first to offer full-scale brokerage services at ATM machines. Option comes to California next month", Los Angeles Times Home Edition, Business Section, page 1, pt. D, col. 5, October 6, 1994 (LA Times).

Mark Leon, "TP-monitor vendors spin Web features - NCR, IBM, BEA Systems enhance products to facilitate transactions over Web", Infoworld, July 1, 1996 (Infoworld).

THE REJECTION

Claims 1-20 stand rejected under 35 U.S.C. § 103 as being unpatentable over LA Times in view of Infoworld.

OPINION

We reverse the aforementioned rejection. We need to address only the independent claims, i.e., claims 1, 2, 4, 7 and 13.

The applied prior art

LA Times discloses that Citibank offers an automatic teller machine (ATM) that lets users buy and sell stocks, get market values for securities, and trade shares of the bank's money market funds. The ATMs have separate menus for banking and brokerage services, and a screen offers a choice between information or trading. If trading is chosen, the next screen is a full page of disclosure about stock market risks. "Those who just want to check stock prices will pull up a picture of a typewriter keyboard. By touching the screen, they can type in the name of the company or its ticker symbol and get a real-time stock quote or the previous day's mutual fund closing price."

Infoworld discloses that NCR Corp. "is out to turn the Internet into a giant virtual cash register with enhancements to its Top End middleware that will let users deploy point-of-sale applications over the World Wide Web." NCR "delivered a Java client to the Top End transaction processing (TP) monitor, a Web specific version of Top End designed to take advantage of the Internet and bypass weaknesses in standard Internet protocols",

and "has rewritten the Top End client code, which runs on PCs and sits inside automated teller machines and cash registers, as a set of Java class libraries." "Rather than establishing a client-to-server connection using Common Gateway Interface (CGI), the Java client downloads into the Web browser and establishes a direct link to the Top End back-end application." Thus, "[i]nstead of going through the Web server and CGI on the back end, [NCR] lets Java set up a private TCP/IP connection."

Claim 1

Claim 1 requires an automatic transaction machine including an output device, a currency sheet dispenser, and software which includes a browser and which, during operation of the currency sheet dispenser, is operative to provide an output through the output device responsive to a document accessed by the browser.

The examiner argues that the Infoworld "browser interface is the interface through which all the ATM banking functions of the NCR ATM machine are performed, such as account access, funds transfer, the dispensing of currency and receipts responsive to the interaction of the user with the web browser interface" (rejection mailed July 15, 2003, paper no. 15, page 4). The disclosures in Infoworld that 1) the client code sites inside the ATM as a set of Java class libraries and runs on PCs, 2) the Java

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client downloads into the Web browser and establishes a direct link to the Top End back-end application, 3) NCR lets Java set up a private TCP/IP connection, 4) NCR's enhancements will let users deploy point-of-sale applications over the World Wide Web, and 5) "[t]he whole idea is to make one or 10,000 machines look as if they are local to your computing resource", indicate that the web browser is in the user's computer, not in the ATM. That is, these disclosures indicate that the client code which runs on PCs is downloaded into the user's web browser to establish a direct link to the Top End back-end application, thereby setting up a private TCP/IP connection that makes the user's computer look as if it is local to the ATM system. The examiner has not explained how Infoworld supports the alternative interpretation argued by the examiner.

Moreover, the examiner has not established that LA Times and Infoworld would have fairly suggested, to one of ordinary skill in the art, a system capable of providing, during operation of a currency sheet dispenser, an output through an output device responsive to a document accessed by the browser. The examiner states that "[t]he examiner takes official notice of the fact that it is notoriously well known in the art of sheet feeders that the documents processed by the controlling web browser

interface of a particular sheet feeding machine contain

instructions for controlling the output devices of the machine,

such as dispense instructions for feeding sheets through the

output devices of the machine, such an arrangement providing an

effective and reliable control system for the output devices of

the machine" (rejection mailed July 15, 2003, paper no. 15,

pages 4-5). An examiner "may take notice of facts beyond the

record which, while not generally notorious, are capable of such

instant and unquestionable demonstration as to defy dispute." *In

re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970).

The facts of which the examiner has taken official notice,

however, do not reasonably appear to be capable of such instant

and unquestionable demonstration as to defy dispute. "Assertions

of technical facts in areas of esoteric technology must always be

supported by citation to some reference work recognized as

standard in the pertinent art and the appellant given, in the

Patent Office, the opportunity to challenge the correctness of

the assertion or the notoriety or repute of the cited reference

[citations omitted]. Allegations concerning specific 'knowledge'

of the prior art, which might be peculiar to a particular art

should also be supported and the appellant similarly given the

opportunity to make a challenge." *Ahlert*, 424 F.2d at 1091, 165

USPQ at 420-21. Because the examiner has not provided such support for the examiner's argument, that argument is not well taken.

We therefore conclude that the examiner has not carried the burden of establishing a *prima facie* case of obviousness of the apparatus claimed in the appellants' claim 1. Accordingly, we reverse the rejection of that claim and claim 15 that depends therefrom.

Claims 2 and 4

Claims 2 and 4 include the above-discussed limitations in claim 1 which, as discussed above regarding the rejection of that claim, the examiner has not shown to have been fairly suggested to one of ordinary skill in the art by the applied prior art.

Claims 2 and 4 further require that a document accessed by the browser includes instructions for causing the computer to operate the sheet dispenser. The examiner relies upon the above-quoted official notice for that claim requirement (rejection mailed July 15, 2003, paper no. 15, pages 4-5). As discussed above regarding the rejection of claim 1, the reliance upon that official notice is not sufficient for establishing a *prima facie* case of obviousness of the claimed invention.

For the above reasons we reverse the rejection of claim 2 and its dependent claim 3, and claim 4 and its dependent claims 5 and 6.

Claims 7 and 13

Claims 7 and 13 require accessing a document with a browser in an automated transaction machine. As discussed above regarding the rejection of claim 1, the examiner has not established that the applied references would have fairly suggested that claim requirement to one of ordinary skill in the art. Alternatively, if the recited browser is considered to be the browser in the user's computer, the examiner has not established that the user's computer having the browser reasonably can be considered to be an automated transaction machine.

Accordingly, we reverse the rejection of claim 7 and claims 8-12 and 16 that depend directly or indirectly therefrom, and claim 13 and claims 14 and 17-20 that depend directly or indirectly therefrom.

DECISION

The rejection of claims 1-20 under 35 U.S.C. § 103 over

LA Times in view of Infoworld is reversed.

REVERSED

Terry J. Owens   )
Administrative Patent Judge)
)
)
Allen R. MacDonald   ) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
)
Robert E. Nappi   )
Administrative Patent Judge)

TJO/eld

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Ralph E. Jocke
231 South Broadway
Medina, OH 44256